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Filing date: **12/11/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048989
Party	Plaintiff Top Tobacco, LP
Correspondence Address	Antony J. McShane Neal, Gerber & Eisenberg LLP Two North LaSalle Street, Suite 2200 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, lhirshfeld@ngelaw.com, amcshane@ngelaw.com, gleighton@ngelaw.com
Submission	Motion to Compel Discovery
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Signature	/Antony J. McShane/
Date	12/11/2008
Attachments	Motion to Compel.pdf ( 131 pages )(5829276 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, LP,	)	
	)	
Petitioner,	)	
	)	
v.	)	Consolidated Cancellation No. 92048989
	)	
VAN NELLE TABAK NEDERLAND BV,	)	
	)	
Respondent.	)	

**TOP TOBACCO'S MOTIONS TO COMPEL DISCOVERY  
AND FOR EXTENSION OF DISCOVERY AND TRIAL PERIODS**

For more than a decade, Respondent has been warehousing the mark ROUTE 66 for use with smoker's articles. It has done so by acquiring a registration for the mark, which Petitioner believes was not in use at the time, and then by obtaining multiple registrations for the mark in various forms. At present, two of the registrations remain, namely Registration Nos. 2,950,896 and 3,328,623, which Respondent obtained more recently under Section 44(e) of the Lanham Act. As Respondent appears neither to have used the mark, nor to have a bona fide intent to use the mark, Petitioner Top Tobacco, LP, ("Top") initiated these proceedings seeking cancellation of the '896 and '623 Registrations pursuant to Sections 44 and 45 of the Lanham Act. In particular, Top believes that to the extent it ever used the mark, Respondent has discontinued use in the United States of the mark ROUTE 66, in any form, with the intent not to resume use in the United States in the foreseeable future and has otherwise not complied with the requirements of Section 44.

Accordingly, these proceedings center on the mark ROUTE 66, and Respondent's past use of the mark (if any) and Respondent's lack of a bona fide intent to use the mark in commerce in the United States in the foreseeable future. By perpetually filing applications in the United

States for over a decade, and taking advantage of a unique facet of the Trademark Laws under Section 44(e), Respondent and its predecessor has, in effect, been able to reserve rights in this mark, without actual use in commerce, or even an intent to use the mark.

In discovery, Respondent has refused to provide information on the mark in all of its various forms. Indeed, Respondent presumably seeks to suppress potentially damaging facts that illustrate Respondent's pattern of preclusively shelving a trademark for nearly a dozen years, with no genuine intent to use the mark. The mark at issue, ROUTE 66, was first sought to be registered by Respondent's predecessor in the mid-1990s, filed on an intent to use basis (resulting in Reg. No. 2,422,437). Over the next decade, Respondent and its predecessor acquired another registration for the mark by assignment (Reg. No. 1,686,628) and filed two additional applications (resulting in Reg. Nos. 3,328,623 and 2,950,896), which were based not on use, but on other foreign registrations of the mark.

Nonetheless, it appears that Respondent has never sold, manufactured, distributed or promoted a product in the United States under the mark. Given the apparent lack of use, Respondent may have acquired any rights it may have in the mark with a "paper" assignment, or what amounts merely to an assignment-in-gross. In fact, the successive U.S. registrations have been cancelled for lack of use of the mark in the United States, with Respondent nevertheless claiming ownership of them, even when it presumably knew there was no such use and after it was aware that they had lapsed. All of these circumstances tend to show that Respondent lacks a genuine intent to resume use of, or even use in the first instance, the ROUTE 66 Mark, and consequently has abandoned it.

Top therefore seeks discovery on Respondent's use and intended use (including its sale, manufacture, distribution and promotion of goods) and adoption of the ROUTE 66 Mark, and

agreements relating to the mark. Respondent has tried to thwart the discovery process by unilaterally limiting the scope of discovery to certain versions of the ROUTE 66 Mark, claiming that information regarding other depictions of the mark are irrelevant to Top's allegations of abandonment and not within a proper or relevant timeframe. Respondent's position has no basis considering the broad and liberal scope of discovery afforded by the Federal Rules of Civil Procedure and the highly probative nature of the information sought by the requests.

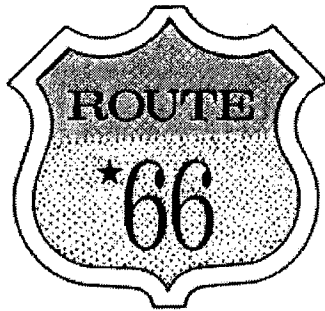
Because Top's discovery requests are both relevant to the claims and defenses in this proceeding, and reasonably calculated to lead to the discovery of admissible evidence, Respondent's objections are not well-taken and little more than an attempt to bury potentially damaging facts and information. Accordingly, pursuant to 37 C.F.R. §2.120(e) and TBMP §523, Top hereby moves this Board for an order to compel the requested discovery, and, when viewed in light of the liberal standards for discoverable information, this motion should be granted.

Counsel for Top states that, pursuant to 37 C.F.R. §2.120(e) and TBMP §523, it has made a good faith effort, by correspondence or conference, with counsel for Respondent to resolve the issues presented in this motion, but the parties have been unable to resolve their differences. Therefore, Top has been forced to seek relief from the Board.

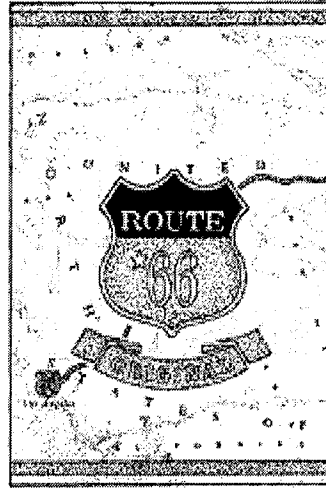
**I. THE REQUESTS ARE DIRECTED TO RESPONDENT'S CESSATION OF USE OF THE ROUTE 66 MARK AND ITS INTENT NOT TO USE THE MARK**

Top seeks discovery on the facts and circumstances surrounding Respondent's prior alleged use of and intent to use the ROUTE 66 Mark in any form. Though there may be others, Top is at least aware of the word mark ROUTE 66 (subject of Registration Nos. 2,422,437 (cancelled) and No. 3,328,623), ROUTE 66 ORIGINAL, which includes a shield design (subject of Registration No. 2,950,896), and ROUTE 66, which is also a shield design (subject of

Registration No. 1,686,628 (cancelled)). See printouts of TARR records from the USPTO electronic database, attached hereto as Exhibit A, and images shown below:



ROUTE 66



ROUTE 66

Reg. No. '628  
Registered 5/12/92

Reg. No. '437  
Registered 1/23/01

Reg. No. '896  
Registered 5/17/05

Reg. No. '623  
Registered 11/6/07

As is evident from the registration records, these marks share various key elements, whether it is the dominant ROUTE 66 words, or the shield design, or both. Yet, Respondent has taken the position that these marks are not related to each other, and therefore information outside of Registration Nos. '623 and '896 is not relevant, and therefore not discoverable.

This attempt by Respondent to hinder fair and complete disclosure of the facts contradicts both the spirit and the letter of the Federal Rules. Consequently, Respondent's objection should be overruled and Respondent should answer Top's requests for information that is reasonably calculated to lead to the discovery of admissible evidence in this matter.

**A. As Defined, Top's Requests Relating to the ROUTE 66 Mark are Appropriately Narrow and Reasonably Calculated to Lead to the Discovery of Admissible Evidence**

Top has requested information regarding Respondent's use and intend use (including its sale, manufacture, distribution and promotion of goods) and adoption of, and agreements relating to the ROUTE 66 Mark. These requests include: Document Request Nos. 2-13, 19-24, 26, 29-

30 and Interrogatory Nos. 2-7, 12, 15-19 on use and intended use; Document Request Nos. 14-17 and 25 and Interrogatory Nos. 11, 13, 14 on Respondent's decision to adopt the mark or apply for registration; and Document Request No. 18 and Interrogatory No. 10 on agreements involving the mark; all of which Top has requested to be answered in accordance with its definition of a ROUTE 66 Mark. Specifically, Top has defined the mark as: "The term 'ROUTE 66 Mark' shall mean any trademark used at any time by Respondent that comprises the term 'Route 66,' in whole or in part, including without limitation the mark 'ROUTE 66 & Design Mark' (Registration No. 1,686,628), 'ROUTE 66 ORIGINAL & Design Mark' (Registration No. 2,950,896), 'ROUTE 66 Mark' (Registration No. 3,328,623)."

Respondent refuses to provide information on anything other than the marks in Registration Nos. 2,950,896 and 3,328,623, claiming that any other marks comprising ROUTE 66 are not relevant to these proceedings and that the requests are unduly burdensome. Yet, none of Respondent's objections to Top's document requests claim that the respective topics are unrelated to the issue of abandonment; rather Respondent asserts objections based on a timeframe, as well as the definition that includes any and all forms of the ROUTE 66 Mark. *See* Resp. to Pet'r First Set of Req. for Produc. of Docs. Nos. 1-26 and 29-30, Exhibit C. For example, Top's Document Request No. 5 seeks "documents representative of the manner in which Respondent uses or intends to use the ROUTE 66 Mark." Pet'r Doc. Req. No. 5, Exhibit B. Respondent has answered this request by stating that it "objects to this request on the ground that what would be 'representative' is vague and undefined. Respondent objects to this request because it does not contain appropriate time and geographic restrictions on the period for which it seeks documents." Resp. to Pet'r Doc. Req. No. 5, Exhibit C. In the same way, Top's Document Request No. 12 seeks "all documents that identify, constitute, or otherwise related to

any publications in which Respondent has placed or intends to place print advertisements, articles or other information in the United States concerning Respondent's cigarettes or any other product(s) offered under the ROUTE 66 Mark." Pet'r Doc. Req. No. 12, Exhibit B. Again, Respondent has objected "because it does not contain appropriate time restrictions on the period for which it seeks documents." Resp. to Pet'r Doc. Req. No. 12, Exhibit C. Similarly, Respondent's answers to Top's interrogatories object to the timeframe covered by the interrogatory, as opposed the relevancy of the information sought. *See* Answers to Pet'r First Set of Interrogs. Nos. 2-7, 12-14 and 17-18, Exhibit E. Respondent's objections have no merit, given that this information falls squarely within the scope of discovery contemplated and permitted by the Federal Rules of Civil Procedure as information related to Top's claim of abandonment or that could reasonably lead to other information bearing on Respondent's intent not to use the mark.

The Federal Rules provide a broad and liberal standard for the scope of discovery: "Parties may obtain discovery regarding any matter, not privileged that is relevant to the claim or defense of any party . . . Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence." Fed. R. Civ. P. 26(b)(1). Relevant information for discovery purposes "has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case." *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 351 (1978), cited in *Hayes v. Dept. of HHS*, 829 F.2d 1092, 1103 (Fed. Cir. 1987). Further, it is well-settled that "it is solely within the discretion of [Top] itself to determine the scope of discovery it will take," within the minimal limitations of Rule 26, and Respondent may not

unilaterally restrict this scope. *Crane Co. v. Shimano Indus. Co., Ltd.*, 184 USPQ 691, 691-92 (TTAB 1975).

Here, Respondent attempts to obstruct Top from obtaining probative, non-privileged, factual information by imposing its own definition of relevancy. As an initial matter, Respondent has failed to object to Top's definition of the ROUTE 66 Mark in Respondent's Answer to Petitioner's First Set of Interrogatories, (Exhibit E, at 4-5), and thus, arguably has waived any objection relating to this definition in regard to the interrogatories. Even if Respondent had objected, though, its claim that Top's definition renders the discovery requests unduly burdensome and not relevant is improper and should be overruled.

In its Petition to Cancel, Top has alleged that "Respondent discontinued use in the United States of the mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future." Consolidated Petition to Cancel, ¶9 (emphasis added), Exhibit F. Respondent has denied this allegation. Answer to Consolidated Petition to Cancel, ¶9, Exhibit G. Top is entitled to fully explore the facts that substantiate its claim or reasonably could lead to other matter that could support its claim. Top is also entitled to test the veracity of Respondent's claims and defenses, and to do so, it is essential that Top obtain information and documents on all ROUTE 66 marks used in the United States by Respondent at any time. To preclude the production of such information by Respondent would unfairly prejudice Top, which has no other means of obtaining these probative facts. *See, e.g., Hickman v. Taylor*, 329 U.S. 495, 507 (1947) ("Mutual knowledge of all the relevant facts gathered by both parties is essential to proper litigation.").



Further, Respondent's own prosecution history illustrates the relevancy of the information sought by Top. Respondent claimed ownership of the '628 Registration (ROUTE 66 & Design) and Registration No. 2,422,437 (ROUTE 66 word mark) to the U.S. Patent and Trademark Office to support its applications that resulted in the '623 (ROUTE 66 word mark) and '896 (ROUTE 66 ORIGINAL & Design) registrations. See Exhibit A. Information concerning these versions of the ROUTE 66 mark and corresponding registrations, and Respondent's use and intent not to resume use thereof, clearly pertain to the subject marks at issue in this proceeding. Thus, while U.S. Registration No. 1,686,628 has subsequently been cancelled by the U.S. Patent and Trademark Office since the commencement of this proceeding, this fact does not render any use or intent to use by Respondent of a ROUTE 66 Mark irrelevant. It cannot be fairly maintained, therefore, as Respondent claims, that "the '628 registration and the subject matter thereof are completely irrelevant" to Top's claim of abandonment of the ROUTE 66 Mark.

The Board has already recognized the relevancy of similar information in *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985). In that case, which involved both oppositions to pending applications and a cancellation of an existing registration, the petitioner sought to compel discovery of sales information by the respondent and its predecessor over a 52-year period. *Id.* at 149. The respondent objected to producing this information, claiming that it was irrelevant. *Id.* The Board disagreed, holding that the information was relevant to the issue of abandonment and could lead to the discovery of admissible evidence. *Id.* Thus, the petitioner's motion to compel was granted. *Id.* So, too, should Top's motion to compel be granted. The information sought by Top regarding

Respondent's ROUTE 66 Mark extends to the timeframe involving any version of the ROUTE 66 Mark, even if it precedes the '896 and '623 Registrations.

Moreover, the cases relied upon by Respondent as a basis for withholding the requested information do not support Respondent's refusal to provide discovery. Indeed, Respondent has provided no authority for its position that these matters are not discoverable. The cases cited by Respondent in its correspondence are all decisions based on summary judgment, with a completely different legal standard than the discoverability threshold established by Rule 26 – which cannot be overlooked. The cases are also factually distinct from this proceeding. For example, Respondent relies upon *Hawaiian Host, Inc. v. Roundtree MacKintosh PLC*, citing language that “the fact that this is a new application and the circumstances surrounding applicant's prior application and resulting registration are of no consequence here.” 225 USPQ 628, 630 (TTAB 1985). That case, however, involved an opposition to a pending application under Section 44(e), not the cancellation of an existing registration. Thus, the Board held that there was no requirement that an applicant under Section 44(e) use the mark prior to registration, and hence, evidence of past non-use was not relevant to the proceeding involving the pending application. *Id.*

In this case, Top is seeking to cancel existing registrations and is therefore permitted to inquire into circumstances that show Respondent has not used the mark and that it has an intent not to resume use. Furthermore, *Hawaiian Host* concerned an applicant who had filed only a second application under Section 44(e). *Id.* Here, Respondent has filed four successive U.S. applications for derivations of the same mark for the same goods, allowing the subsequent registrations to expire for failure to use the mark in commerce. These are exactly the types of

circumstances of potential abuse noted by the Senate Judiciary Committee in its 1988 report on the revision of the Lanham Act, in discussing the bona fide intent to use the mark in commerce:

[O]ther circumstances may cast doubt on the bona fide nature of the intent or even disprove it entirely. For example, the applicant may have filed . . . numerous intent-to-use applications to replace applications which have lapsed because no timely declaration of use has been filed, [or] an excessive number of intent-to-use applications to register marks which ultimately were not actually used . . . Other circumstances may also indicate the absence of a genuine bona fide intent to actually use the mark.

S. Rep. 100-515, 1988 U.S.C.C.A.N. 5577. Top should be allowed to explore the circumstances surrounding each of the ROUTE 66 applications and any other uses of a ROUTE 66 Mark in the United States, given that this pattern suggests a lack of a true intent to use the mark in commerce.

Similarly, Respondent's reliance on *Consolidated Cigar Corp. v. Rodriguez* is misplaced. 65 USPQ2d 1153, 1155 (TTAB 2002). In *Consolidated Cigar*, the question at issue was whether the time while an intent-to-use application is pending and prior to the filing of a statement of use could be considered, as a matter of law, part of the statutory three-year period that creates the presumption of abandonment. *Id.* Again, this case is not at the summary judgment stage, nor is Top attempting to rely on a presumption of abandonment. Top is seeking discovery as to facts that may tend to show that Respondent lacks the intent to resume use of (or even use) the ROUTE 66 Mark in the United States.

Accordingly, Top's definition of the ROUTE 66 Mark, and the corresponding timeframe, are appropriate in scope, and its requests relevant and reasonably calculated to lead to the discovery of admissible evidence. Therefore, Top respectfully requests that the Board enter an order requiring Respondent to supplement its responses to Interrogatory Nos. 2-7 and 10-19, and Document Requests Nos. 2-26 and 29-30 to include non-privileged information relating to any ROUTE 66 Mark used at any time by Respondent.

**B. Respondent Has Not Provided Other Relevant Information As Promised**

In addition, in regard to two discovery requests, Top seeks information that Respondent has promised to provide, but has not done so. In particular, Respondent has promised to provide the identification of the relevant principals of Commonwealth Brands, Inc., and J.D. Getty Enterprises, Inc., in response to Interrogatory No. 2. *See* Exhibit H, Sept. 10, 2008 letter from B. Taylor. Further, Respondent has promised to respond to Document Request No. 32 regarding Respondent's document retention policy. *Id.* As of the filing of this Motion, Respondent has not yet provided such information. Accordingly, Top respectfully requests that the Board enter an order requiring Respondent to provide the information as to these two requests as well.

**II. THE DISCOVERY AND TRIAL PERIODS SHOULD BE EXTENDED**

Top also requests that the Board enter an order to extend the trial and discovery periods for 60 days, pursuant to 37 C.F.R. §§120-21 and TBMP §509. Top has good cause for this motion because it has been diligent in attempting to resolve the dispute over the production of information related to all forms of the ROUTE 66 Mark, no previous extensions have been entered in this matter, and no prejudice would result to Respondent by such an extension.

"Ordinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused." *Am. Vitamin Prods Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). In this matter, the discovery period opened on June 22, 2008, pursuant to Board's May 27, 2008, order. Top served its first set of interrogatories and first set of requests for the production of documents on June 23, 2008. After receiving Respondent's responses to these requests, Top's counsel engaged in regular correspondence with Respondent's counsel regarding the issues that are the subject of Top's Motion to Compel. (See letters dated August 27, 2008, September 10, 2008, September 16, 2008, November 3, 2008, and

November 21, 2008, attached collectively hereto as Exhibit H). Since its recent November 21 letter, however, Top's counsel has been met with silence from Respondent's counsel, in regard to both the outstanding objections to discovery requests, as well as Top's request to determine potential dates and availability to depose Respondent's witnesses.

In light of Respondent's insufficient responses and unwillingness to provide relevant information in response to Top's discovery requests, Top has been unable to obtain critical facts related to its claims and defenses. Top believes it should be afforded the opportunity to examine the facts and circumstances related to Respondent's use and intent regarding any of its ROUTE 66 Marks. *See Sunkist*, 229 USPQ at 149 (after granting petitioner's motion to compel, "clearly ... it is reasonable to allow [petitioner] to complete its discovery before progressing into its testimony"). Further, Respondent will suffer no harm or prejudice by such an extension at this stage in the proceedings. Therefore, Top respectfully requests that the Board enter an order extending the discovery and trial periods in this matter for 60 days, to allow for the full and orderly completion of discovery, which will provide the best result on the merits of this case.

Respectfully submitted,

December 11, 2008

/Antony J. McShane/  
One of the Attorneys for Petitioner,  
Top Tobacco, L.P.

Antony J. McShane  
Michael G. Kelber  
Hillary A. Mann  
NEAL, GERBER & EISENBERG LLP  
2 North LaSalle Street, Suite 2200  
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Telephone: 312.269.8000

**CERTIFICATE OF SERVICE**

I, Hillary A. Mann, an attorney, state that I caused a copy of the foregoing, Top's Tobacco's Motions to Compel Discovery and for Extension of Discovery and Trial Periods, to be served upon:

Brewster Taylor  
STITES & HARBISON, PLLC  
1199 North Fairfax Street  
Suite 900  
Alexandria, VA 22314-1437

via U.S. Mail on this December 11, 2008.

/Hillary A. Mann/  
Hillary A. Mann, Esq.

NGEDOCs: 1586499.2

# **EXHIBIT A**



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#### Typed Drawing

Word Mark	ROUTE 66
Goods and Services	(CANCELLED) IC 034. US 002 008 009 017. G & S: Cigarettes and lighters not of precious metal. FIRST USE: 19980300. FIRST USE IN COMMERCE: 19980300
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75208878
Filing Date	December 5, 1996
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	October 31, 2000
Registration Number	2422437
Registration Date	January 23, 2001
Owner	(REGISTRANT) VAN NELLE TABAK NEDERLAND BV CORPORATION NETHERLANDS P.O. BOX 71744 1008 DE AMSTERDAM NETHERLANDS
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	BREWSTER TAYLOR
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Cancellation Date	October 27, 2007

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# ROUTE 66

**Word Mark**  
**Goods and**  
**Services**

ROUTE 66

IC 034. US 002 008 009 017. G & S: CIGARETTES, CIGARS, CIGARILLOS, TOBACCO, MATCHES, LIGHTERS AND ASHTRAYS NOT MADE OF PRECIOUS METALS, PIPES, TOBACCO CASES NOT MADE OF PRECIOUS METALS, CIGARETTE PAPERS, CIGARETTE FILTERS, CIGARETTE TUBES, AND HAND-HELD MACHINES FOR ROLLING AND MAKING CIGARETTES

**Standard**  
**Characters**  
**Claimed**

**Mark Drawing**  
**Code**

(4) STANDARD CHARACTER MARK

**Trademark**  
**Search Facility**  
**Classification**  
**Code**

NUM-26-UP 66 Other Numerals - 26 and Up

**Serial Number**

77105156

**Filing Date**

February 12, 2007

**Current Filing**  
**Basis**

44E

**Original Filing**  
**Basis**

1B;44E

**Published for**  
**Opposition**

August 21, 2007

**Registration**  
**Number**

3328623

**Registration**  
**Date**

November 6, 2007

**Owner**

(REGISTRANT) VAN NELLE TABAK NEDERLAND BV CORPORATION NETHERLANDS SLACHTEDIJK  
28A 8501 ZA JOURE NETHERLANDS

**Attorney of**  
**Record**

BREWSTER TAYLOR

Prior Registrations 1686628;2422437;2950896  
Type of Mark TRADEMARK  
Register PRINCIPAL  
Live/Dead Indicator LIVE

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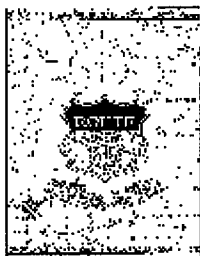
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**Word Mark**

ROUTE 66 ORIGINAL

**Goods and Services**

IC 034. US 002 008 009 017. G & S: TOBACCO WHETHER MANUFACTURED OR UNMANUFACTURED; TOBACCO PRODUCTS, NAMELY, HAND-ROLLING TOBACCO, CIGARS, CIGARETTES; TOBACCO SUBSTITUTES, NONE BEING FOR MEDICINAL OR CURATIVE PURPOSES; SMOKERS' ARTICLES, NAMELY, CIGARETTE LIGHTERS NOT OF PRECIOUS METAL, ASHTRAYS NOT OF PRECIOUS METAL, CIGARETTE PAPERS, MATCHES

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code**

01.01.03 - Star - a single star with five points  
01.17.08 - Maps of the United States; United States, maps of  
18.15.03 - Other road signs  
24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon  
24.09.07 - Advertising, banners; Banners  
26.11.21 - Rectangles that are completely or partially shaded

**Serial Number**

76487927

**Filing Date**

February 6, 2003

**Current Filing Basis**

44E

**Original Filing Basis**

1B;44D

**Published for Opposition**

September 21, 2004

**Registration Number**

2950896

**Registration Date**

May 17, 2005

**Owner**

(REGISTRANT) VAN NELLE TABAK NEDERLAND BV CORPORATION NETHERLANDS SLACHTEDYK  
28A 8501 ZA JOURE NETHERLANDS

**Attorney of Record**

Brewster Taylor

**Priority Date** September 4, 2002

**Prior Registrations** 1686628;2422437

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ORIGINAL" APART FROM THE MARK AS SHOWN

**Description of Mark** The mark includes the wording "ROUTE 66 ORIGINAL," a fanciful ribbon and shield design, and a fanciful map of a portion of the western United States including Route 66 with a shield and a highway designation number 66. The stippling is a feature of the mark and does not indicate color.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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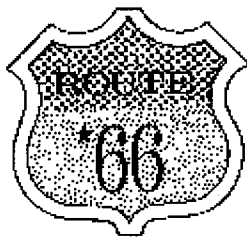
[ASSIGN Status](#)

[TDR](#)

[TTAB Status](#)

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Browser to return to TESS)



**Word Mark**  
**Goods and**  
**Services**

ROUTE 66

(CANCELLED) IC 032. US 045 046 048. G & S: [ BEER, ALE, LAGER, STOUT, AND SHANDY; SOFT DRINKS; SYRUPS AND CONCENTRATES FOR MAKING SOFT DRINKS; FRUIT JUICES ]

(CANCELLED) IC 034. US 002 008 009 017. G & S: CIGARETTES, [ CIGARS, CIGARILLOS; SMOKING TOBACCO, CHEWING TOBACCO, SNUFF, MATCHES, ] LIGHTERS [ , ASHTRAYS, PIPES, TOBACCO CASES NOT OF PRECIOUS METAL AND CIGARETTE PAPERS ]

**Mark Drawing**  
**Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search**  
**Code**

01.01.03 - Star - a single star with five points

24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon

24.01.03 - Shields or crests with letters, punctuation or inscriptions contained therein or superimposed thereon

24.01.04 - Shields or crests with numbers contained therein or superimposed thereon

25.03.05 - Backgrounds covered with dots; Dotted backgrounds

**Serial Number**

73745820

**Filing Date**

August 12, 1988

**Current Filing**  
**Basis**

44E

**Original Filing**  
**Basis**

44D;44E

**Published for**  
**Opposition**

February 18, 1992

**Change In**  
**Registration**

CHANGE IN REGISTRATION HAS OCCURRED

**Registration**  
**Number**

1686628

**Registration**  
**Date**

May 12, 1992

**Owner**

(REGISTRANT) LEVY, MAIRADE ANN INDIVIDUAL IRELAND 148A RUSTHALL AVENUE LONDON

W41BS ENGLAND

(REGISTRANT) LEVY, ANDRE JACQUES INDIVIDUAL UNITED KINGDOM 148A RUSTHALL AVENUE  
LONDON W41BS ENGLAND

(LAST LISTED OWNER) NAVIGATOR INC. CORPORATION ASSIGNEE OF BAHAMAS EURO-  
CANADIAN CENTRE MARLBOROUGH ST., 1ST FLOOR NASSAU BAHAMAS

<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	BREWSTER TAYLOR
<b>Priority Date</b>	May 5, 1988
<b>Description of Mark</b>	THE STIPPLING SHOWN IN THE DRAWING OF THE MARK IS FOR SHADING PURPOSES ONLY.
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	PARTIAL SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	DEAD
<b>Cancellation Date</b>	May 20, 2008

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<a href="#">TESS HOME</a>	<a href="#">NEW USER</a>	<a href="#">STRUCTURED</a>	<a href="#">FREE FORM</a>	<a href="#">BROWSE DICT</a>	<a href="#">SEARCH OG</a>	<a href="#">TOP</a>	<a href="#">HELP</a>
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# **EXHIBIT B**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, L.P.,	)	
	)	
Petitioner,	)	Consolidated Cancellation No. 92048989
	)	
VAN NELLE TABAK NEDERLAND BV,	)	
	)	
Respondent.	)	

**PETITIONER'S FIRST SET OF REQUESTS  
FOR THE PRODUCTION OF DOCUMENTS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Petitioner Top Tobacco, L.P. hereby requests that Respondent Van Nelle Tabak Nederland BV produce to Petitioner's attorneys the items described hereafter for inspection and copying at the offices of Neal, Gerber & Eisenberg, Two North LaSalle Street, Suite 2300, Chicago, Illinois 60602, within thirty (30) days after the service hereof.

A. Definitions

As used herein, the words and phrases set out below shall have the meaning or meanings prescribed for them:

1. The term "Petitioner" shall mean petitioner Top Tobacco, L.P., as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.
2. The term "Respondent" shall mean respondent Van Nelle Tabak Nederland BV, as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.
3. The term "person" shall mean any individual, firm, partnership, corporation, proprietorship, association, or other organization or entity.



4. The term “documents” shall mean any and all writings of any nature whatsoever or other means by which information is retained in retrievable form, as well as drafts and all non-identical copies thereof, including but not limited to memoranda, stenographic or handwritten notes, contracts, agreements, records, audio and video recordings, correspondence, communications, reports, studies, summaries, surveys, statistical compilations, minutes, charts, manuals, brochures, schedules, price lists, telegrams, teletypes, facsimiles, E-mail, signage, certificates of registration, labels, specimens, writings, sketches, and computer disks, and any other documents as defined in Rule 34 of the Federal Rules of Civil Procedure.

5. “Relate to,” “related to,” or “relating to” shall mean directly or indirectly mentioning or describing, pertaining to, connected with, or reflecting upon a stated subject matter.

6. The term “ROUTE 66 Mark” shall mean any trademark used at any time by Respondent that comprises the term “Route 66,” in whole or in part, including without limitation the mark “ROUTE 66 & Design Mark”(Registration No. 1,686,628), “ROUTE 66 ORIGINAL & Design Mark” (Registration No. 2,950,896), “ROUTE 66 Mark” (Registration No. 3,328,623).

B. Instructions

1. The singular shall include the plural and the plural shall include the singular.

2. A masculine, feminine or neuter pronoun shall not exclude the other genders.

3. The terms “and” and “or” shall be construed disjunctively or conjunctively as necessary to bring within the scope of each document request all information that might otherwise be construed to be outside of its scope.

4. All objections to discovery requests which fail or refuse to fully respond to any request on the ground of any claim of privilege of any kind whatever shall:

a. State the nature of the claim of privilege;

- b. State all facts relied upon in support of or related to the claim of privilege;
- c. Identify all documents in support of or related to the claim of privilege; and
- d. Identify all persons having knowledge of any facts related to the claim of privilege.

5. These document requests shall be deemed to be continuing in nature and shall include documents which are discovered subsequent to any initial compliance herewith. Such later discovered documents shall be produced within thirty (30) days after their discovery.

6. All objections or answers to these document requests which fail or refuse to fully respond to any document request on the ground of any claim of privilege of any kind whatever shall:

- a. state the nature of the claim of privilege;
- b. state all facts relied upon in support of the claim of privilege or related thereto;
- c. identify all documents related to the claim of privilege;
- d. identify all persons having knowledge of any facts related to the claim of privilege; and
- e. identify all events, transactions or occurrences related to the claim of privilege.

7. In an effort to promote an orderly presentation of documentary evidence in this matter, Petitioner requests that Respondent consecutively mark each document produced in response to the following requests by placing Respondent's initials followed by a number in the lower right-hand corner of each document.

C. Requests for Production

- 1. Documents sufficient to identify the following:
  - a. When Respondent was first licensed to do business;

- b. All places where Respondent is licensed or qualified to do business; and/or
  - c. All corporations or other entities in which Respondent has a controlling interest.
- 2. All documents concerning the display or intended display of the ROUTE 66 Mark.
- 3. Representative samples of each cigarette or other product(s) offered or intended to be offered, sold or intended to be sold, or distributed or intended to be distributed by Respondent in the United States under the ROUTE 66 Mark.
- 4. Documents sufficient to identify the persons most familiar with and primarily responsible for Respondent's use or intended use of the ROUTE 66 Mark in the United States.
- 5. Documents representative of the manner in which Respondent uses or intends to use the ROUTE 66 Mark.
- 6. Documents sufficient to identify the geographic scope in the United States in which Respondent has sold or intends to sell, or otherwise used or intends to use the ROUTE 66 Mark in connection with cigarettes or any other product(s).
- 7. All documents that disclose, describe, or otherwise relate to the date Respondent first marketed or offered to provide cigarettes or any other product(s) under the ROUTE 66 Mark in the United States.
- 8. Documents sufficient to identify the person(s) most knowledgeable concerning the date when Respondent first used the ROUTE 66 Mark in intrastate commerce and/or interstate commerce.
- 9. For each and every good offered or intended to be offered by Respondent under the ROUTE 66 Mark in the United States, documents sufficient to identify:
  - a. the prices Respondent charges in connection with each such good;

- b. Respondent's annual sales (in units and dollars) of each such good, by state; and
- c. Respondent's current inventory, if any, of each such good.

10. All sales records, purchase agreements, invoices, and shipping documents for each quarter in the years 2005 through the present related to any ROUTE 66 Mark.

11. All documents sufficient to fully describe the manner by which Respondent advertises or promotes, or intends to advertise or promote, cigarettes or any other product(s) under the ROUTE 66 Mark.

12. All documents that identify, constitute, or otherwise relate to any publications in which Respondent has placed or intends to place print advertisements, articles or other information in the United States concerning Respondent's cigarettes or any other product(s) offered under the ROUTE 66 Mark.

13. All documents that disclose, depict, or otherwise relate to any Internet website referencing Respondent's use of the ROUTE 66 Mark, including but not limited to printouts of all such website pages.

14. All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to apply for registration of the ROUTE 66 ORIGINAL & Design Mark, Serial No. 76/487,927, including but not limited to all documents related to any discussions concerning such decision(s).

15. All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to apply for registration of the ROUTE 66 Mark, Serial No. 77/105,156, including but not limited to all documents related to any discussions concerning such decision(s).

16. All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to abandon the ROUTE 66 & Design Mark, Registration No. 1,686,628.

17. All documents that disclose, describe, or otherwise relate to Application Serial Nos. 73/745,820, 76/487,927, and 77/105,156, including all communications with the United States Patent & Trademark Office.

18. All documents that disclose, describe, or otherwise relate to any license or assignment agreement(s) to which Respondent, or any related party, is a party concerning the ROUTE 66 Mark.

19. Documents sufficient to disclose all marketing, advertising and promotional expenditures by quarter incurred by Respondent in connection with the use of the ROUTE 66 Mark in the United States for cigarettes or any other product for the past five years.

20. Specimens of representative packaging, hang tags, wrappings, promotional literature, and labeling of every product or service that Respondent has marketed, distributed, sold, or offered for sale under the ROUTE 66 Mark in the United States.

21. Documents sufficient to identify all entities that currently sell or will sell Respondent's cigarettes or any other product(s) bearing the ROUTE 66 Mark in the United States.

22. All documents evidencing, supporting or concerning Respondent's claim that Respondent has not abandoned the ROUTE 66 Mark.

23. All marketing and business plans relating to or concerning the ROUTE 66 Mark.

24. All forecasts or sales projections for products to be sold or distributed under the ROUTE 66 Mark for the next five years.

25. All documents reflecting Respondent's intent to resume use in the United States of the ROUTE 66 Mark after any periods of non-use, including all memorandum, prototypes, advertising specimens, and correspondence.

26. All documents reflecting or relating to advertising or marketing agencies that performed work for Respondent in connection with the ROUTE 66 Mark.

27. All documents relating to Respondent's efforts to make use of the mark ROUTE 66, Registration No. 3,328,623, in commerce in the United States in connection with the goods in the Registration.

28. All documents relating to Respondent's efforts to make use of the mark ROUTE 66 ORIGINAL & Design, Registration No. 2,950,896, in commerce in the United States in connection with the goods in the Registration.

29. All documents relating to Respondent's research and development activities in connection with Respondent's use or intended use of the ROUTE 66 Mark in the United States, including all market research, manufacturing activities, steps taken to acquire distributors, and steps taken to obtain required governmental approval.

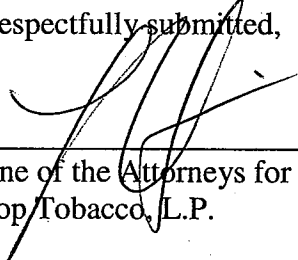
30. All documents referring or relating to communications between Respondent and the National Association of Attorneys Generals regarding Respondent's intent to manufacture and sell products in connection with the ROUTE 66 Mark.

31. All documents consulted in the preparation of, or which are requested to be identified in, Respondent's answers to Petitioner's First Set of Interrogatories.

32. All documents relating to any document retention policy of Respondent or the destruction of documents by Respondent at any time.

Dated: June 23, 2008

Respectfully submitted,



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One of the Attorneys for Petitioner,  
Top Tobacco, L.P.

Antony J. McShane  
Lara V. Hirshfeld  
Gregory Leighton  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street  
Suite 2200  
Chicago, Illinois 60602  
(312) 269-8000

**CERTIFICATE OF SERVICE**

I, Lara V. Hirshfeld, an attorney, state that I served a true and correct copy of Petitioner's

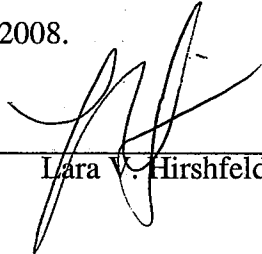
First Set of Requests for the Production of Documents, upon:

Brewster Taylor  
STITES & HARBISON, PLLC  
Suite 900 1199 North Fairfax Street  
Alexandria, VA 22314-1437

Amy Cahill  
STITES & HARBISON, PLLC  
400 W. Market Street, Suite 1800  
Louisville, KY 40202-3352

by Email and First Class Mail, on this 23rd day of June, 2008.

NGEDOCs: 1514078.2

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Lara V. Hirshfeld



# **EXHIBIT C**



3. Respondent objects to each instruction, definition, and request to the extent it seeks documents and things protected from disclosure by the attorney-client privilege, work product doctrine, or any other applicable privilege or immunity, including any applicable right of privacy.

4. Respondent objects to each instruction, definition, and request to the extent it calls for a privilege log with greater or different requirements from those prescribed by the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

5. Respondent objects to terms and phrases defined or used by Petitioner to the extent those terms and/or phrases are vague and/or ambiguous or beyond their customary meaning. To the extent Respondent adopts any terms or phrases defined or used by Petitioner, they are adopted solely for the sake of convenience in responding to these requests, and Respondent does not accept or concede that any of the terms, phrases or definitions are appropriate, descriptive or accurate.

6. Respondent objects to each instruction, definition, and request to the extent they are overly broad and inconsistent with the applicable discovery rules by purporting to require Respondent to search for and produce documents and/or things that are not in its own possession, custody, or control. Respondent's responses to these requests are limited to documents and things that are within Respondent's possession, custody, or control.

7. Respondent objects to each request to the extent that it seeks production of publicly available documents that are equally available to Petitioner.

8. Respondent objects to each request to the extent it is overbroad in that it seeks documents and things that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence relevant to the subject matter of this proceeding.

9. Respondent objects to each request as overly broad and unduly burdensome to the extent it is unlimited in temporal scope or otherwise not limited to a time frame relevant to this proceeding and the trademarks at issue.

10. Respondent objects to each request to the extent it is unduly burdensome insofar as it may be construed to require Respondent to recreate files or documents no longer in existence or to require Respondent to make an unduly burdensome search for documents.

11. Respondent objects to each request to the extent it seeks documents or things that Respondent is obligated not to disclose to third parties absent a court order. Respondent will make any such documents or things available after Respondent has the opportunity to provide such third parties with notice of Petitioner's requests and after issuance of a court order directing Respondent to produce the requested documents or things.

12. Respondent objects to each request seeking "all documents" relating to or referring to a particular subject matter as overly broad and unduly burdensome, and as seeking documents or things which are not reasonably calculated to lead to the discovery of admissible evidence.

13. In addition to these General Objections, Respondent has specific objections to certain definitions, instructions, and document requests as set forth below. By stating these specific objections, Respondent does not waive any of the general objections that may also be applicable to specific document requests.

14. Respondent objects to the document requests to the extent they call for Respondent's or third parties' confidential information, including trade secrets, research and development, or commercial information protected from disclosure by Federal Rule of Civil Procedure 26(c) and/or a suitable protective order. Respondent will produce such documents

or information – to the extent they are responsive, not privileged, and not covered by any other objection – pursuant to and subject to the protective order in this case.

15. Respondent reiterates and incorporates by reference as if set forth here in full the General Objections and Objections to Instructions and Definitions contained in its responses to Petitioner' first set of interrogatories. To the extent any such incorporated objection refers to an interrogatory by Petitioner, it shall be deemed to be applicable to the requests for production of documents and things responded to herein.

16. In the interest of expediting production, Respondent has been making prompt and diligent reviews of its potentially responsive documents, accompanied by what Respondent feels to be reasonable safeguards against the production of privileged or otherwise protected or non-responsive documents. If, despite such efforts, Respondent does in fact produce one or more such documents, such production will have been inadvertent and not intended in any way whatsoever to waive any legal protection that attaches to such document(s). Respondent objects to any reading, copying, summarizing or other use by Petitioner of such document(s), and requests that Petitioner immediately notify Respondent of any instance where it knows, or reasonably suspects, that such an inadvertent production has occurred, and immediately return such document(s) to Respondent.

17. By responding to each request, Respondent does not concede the relevancy or materiality of the request or of the subject to which such request refers. Respondent's responses are made expressly subject to, and without waiving or intending to waive, any questions or objections to the competence, relevance, materiality, privilege, or admissibility as evidence for any other purpose, of any of the documents referred to or produced or of the responses given herein, or of the subject matter thereof, in any proceeding (including the trial of this action or in any subsequent proceeding). The responses and production are made

subject to Respondent's right to object to any discovery proceeding involving or relating to the subject matter of the request responded to herein.

18. Respondent's investigations are continuing and it reserves the right to amend or modify its responses to the requests. These responses are based on information presently known to Respondent and are given without prejudice to Respondent's right to produce evidence of any subsequently discovered document or facts.

### **OBJECTIONS TO INSTRUCTIONS AND DEFINITIONS**

1. Respondent objects to the defined term "Petitioner" to the extent it includes the phrase "as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees" as being vague, ambiguous and overly broad as Petitioner fails to identify or to give Respondent notice of the identity of Petitioner's predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

2. Respondent objects to the defined term "Respondent" to the extent Petitioner seeks to include within the penumbra of this definition any person or entity that is not properly within Respondent's control or any other person or entity that is not involved in and otherwise has no connection to this litigation, rendering Petitioner's interrogatories overly broad, unduly burdensome, irrelevant, and not likely to lead the discovery of admissible evidence.

3. Respondent objects to the defined term "person" in that it is overly broad and unduly burdensome and also to the extent that it exceeds the requirements for responding to a request for production under Federal Rule of Civil Procedure 34.

4. Respondent objects to the defined term "documents" to the extent Petitioner seeks to broaden the definition of "documents" provided by the Federal Rules of Civil Procedure, to the extent Petitioner seeks documents no longer in Respondent's possession, custody, or control, to the extent the definition seeks to include drafts or other preliminary

versions of documents which are neither relevant nor likely to lead to the discovery of admissible evidence, and to the extent Petitioner seeks documents protected from disclosure by the attorney-client privilege, work product doctrine, or are otherwise immune from discovery.

5. Respondent objects to the defined terms “relate to,” “related to,” and “relating” in that they are overly broad and unduly burdensome and also to the extent that they exceed the requirements for responding to a request for production under Federal Rule of Civil Procedure 34.

6. Respondent objects to the defined term “ROUTE 66 Mark” to the extent the definition seeks to include Registration No. 1,686,628, because it renders the request unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence.

#### **OBJECTIONS TO INSTRUCTIONS**

1. Respondent objects to Instruction No. 4 on the grounds that it exceeds the requirements for responding to a request for production under Federal Rule of Civil Procedure 34.

2. Respondent objects to Instruction No. 5 to the extent it exceeds or is otherwise inconsistent with the obligations to supplement discovery responses under the Federal Rules of Civil Procedure.

3. Respondent objects to Instruction No. 6 on the grounds that it exceeds the requirements for responding to a request for production under Federal Rule of Civil Procedure 34.

4. Respondent objects to Instruction No. 7 on the grounds that it exceeds the requirements for responding to a request for production under Federal Rule of Civil Procedure 34.

## **RESPONSES AND SPECIFIC OBJECTIONS TO REQUESTS FOR PRODUCTION**

**REQUEST NO. 1** Documents sufficient to identify the following:

- (a) When Respondent was first licensed to do business;
- (b) All places where Respondent is licensed or qualified to do business; and/or
- (c) All corporations or other entities in which Respondent has a controlling interest.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent it seeks the production of documents that are neither relevant nor likely to lead to the discovery of admissible evidence, namely documents relating to places, corporations and entities that are not at issue in this action. Respondent also objects to this request because it does not contain appropriate time and geographic restrictions on the period for which it seeks documents. In addition, Respondent objects to this request on the ground that what would be “sufficient” is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 2** All documents concerning the display or intended display of the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain appropriate time and geographic restrictions on the period for which it seeks documents. Use



of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 3** Representative samples of each cigarette or other product(s) offered or intended to be offered, sold or intended to be sold, or distributed or intended to be distributed by Respondent in the United States under the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request on the ground that what would be “representative” is vague and undefined. Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 4** Documents sufficient to identify the persons most familiar with and primarily responsible for Respondent’s use or intended use of the ROUTE 66 Mark in the United States.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request on the ground that what would

be “sufficient” is vague and undefined. Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 5** Documents representative of the manner in which Respondent uses or intends to use the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request on the ground that what would be “representative” is vague and undefined. Respondent objects to this request because it does not contain appropriate time and geographic restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 6** Documents sufficient to identify the geographic scope in the United States in which Respondent has sold or intends to sell, or otherwise used or intends to use the ROUTE 66 Mark in connection with Cigarettes or any other product(s).

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain

appropriate time restrictions on the period for which it seeks documents. Respondent also objects to this request on the ground that what would constitute "sufficient" is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent states that no such documents exist.

**REQUEST NO. 7** All documents that disclose, describe, or otherwise relate to the date Respondent first marketed or offered to provide cigarettes or any other product(s) under the ROUTE 66 Mark in the United States.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control relating to the date it first marketed or offered to provide cigarettes or any other product(s) under the ROUTE 66 mark in the United States subsequent to February 1, 2003. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 8** Documents sufficient to identify the person(s) most knowledgeable concerning the date when Respondent first used the ROUTE 66 Mark in intrastate commerce and/or interstate commerce.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request on the ground that what would constitute “sufficient” is vague and undefined. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents and appropriate geographical restrictions.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 9** For each and every good offered or intended to be offered by Respondent under the ROUTE 66 Mark in the United States, documents sufficient to identify:

- (a) the prices Respondent charges in connection with each such good;
  - (b) Respondent’s annual sales (in units and dollars) of each such good, by state;
- and
- (c) Respondent’s current inventory, if any, of each such good.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request on the ground that what would be “sufficient” is vague and undefined. Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be

produced subject to the protective order in this case.

**REQUEST NO. 10** All sales records, purchase agreements, invoices, and shipping documents for each quarter in the years 2005 through the present related to any ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the United States. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 11** All documents sufficient to fully describe the manner by which Respondent advertises or promotes, or intends to advertise or promote; cigarettes or any other product(s) under the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the United States. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. In addition, Respondent objects to this request on the ground that what would constitute “sufficient” is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated

General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 12** All documents that identify, constitute, or otherwise relate to any publications in which Respondent has placed or intends to place print advertisements, articles or other information in the United States concerning Respondent's cigarettes or any other product(s) offered under the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 13** All documents that disclose, depict, or otherwise relate to any Internet website referencing Respondent's use of the ROUTE 66 Mark, including but not limited to printouts of all such website pages.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the United States. Respondent also objects to this request because it does not contain

appropriate time restrictions on the period for which it seeks documents. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request to the extent it seeks documents which are publicly available and which may be easily obtained by Petitioner, such as the information available on Respondent’s website.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 14** All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to apply for registration of the ROUTE 66 ORIGINAL & Design Mark, Serial No. 76/487,927, including but not limited to all documents related to any discussions concerning such decision(s).

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such

documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 15** All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to apply for registration of the ROUTE 66 Mark, Serial No. 77/105,156, including but not limited to all documents related to any discussions concerning such decision(s).

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 16** All documents that disclose, describe, or otherwise relate to the decision by Respondent or its affiliates, or their predecessors, to abandon the ROUTE 66 & Design Mark, Registration No. 1,686,628.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client



privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. Respondent further objects to this request because it is improperly based on a legal conclusion that it made a decision to abandon the ROUTE 66 and Design Mark in U.S. Registration No. 1,686,638.

**REQUEST NO. 17** All documents that disclose, describe, or otherwise relate to Application Serial Nos. 73/745,820, 76/487,927, and 77/105,156, including all communications with the United States Patent & Trademark Office.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control relating to Application Serial Nos. 76/487,927 and 77/105,156. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 18** All documents that disclose, describe, or otherwise relate, to any license or assignment agreement(s) to which Respondent, or any related party, is a party concerning the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. In addition, Respondent objects to this request because it is not confined to the United States.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent states that it will produce any relevant non-privileged responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary information, they will be produced subject to the protective order in this case.

**REQUEST NO. 19** Documents sufficient to disclose all marketing, advertising and promotional expenditures by quarter incurred by Respondent in connection with the use of the ROUTE 66 Mark in the United States for cigarettes or any other product for the past five years.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the relevant time period. In addition, Respondent objects to this request on the ground that what would be “sufficient” is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 20** Specimens of representative packaging, hang tags, wrappings, promotional literature, and labeling of every product or service that Respondent has marketed, distributed sold, or offered for sale under the ROUTE 66 Mark in the United States.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the relevant time period. In addition, Respondent objects to this request on the ground that what would be "representative" is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 21** Documents sufficient to identify all entities that currently sell or will sell Respondent's cigarettes or any other product(s) bearing the ROUTE 66 Mark in the United States.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the relevant time period. In addition, Respondent objects to this request on the ground that what would be "sufficient" is vague and undefined.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 22** All documents evidencing, supporting or concerning Respondent's claim that Respondent has not abandoned the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. In addition, Respondent objects to this request because it is not confined to the United States.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 23** All marketing and business plans relating to or concerning the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain

appropriate time restrictions on the period for which it seeks documents. In addition, Respondent objects to this request because it is not confined to the United States. Use of the term “[a]ll” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 24** All forecasts or sales projections for products to be sold or distributed under the ROUTE 66 Mark for the next five years.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it is not confined to the United States. Use of the term “[a]ll” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent states that no such documents exist.

**REQUEST NO. 25** All documents reflecting Respondent’s intent to resume use in the United States of the ROUTE 66 Mark after any periods of non-use, including all memorandum, prototypes, advertising specimens, and correspondence.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client

privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 26** All documents reflecting or relating to advertising or marketing agencies that performed work for Respondent in connection with the ROUTE 66 Mark.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. In addition, Respondent objects to this request because it is not confined to the United States. Use of the term “[a]ll” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 27** All documents relating to Respondent's efforts to make use of the mark ROUTE 66, Registration No. 3,328,623, in commerce in the United States in connection with the goods in the Registration.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 28** All documents relating to Respondent's efforts to make use of the mark ROUTE 66 ORIGINAL & Design, Registration No. 2,950,896, in commerce in the United States in connection with the goods in the Registration.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive.

Subject to and without waiver of the foregoing specific objections and incorporated

General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 29** All documents relating to Respondent's research and development activities in connection with Respondent's use or intended use of the ROUTE 66 Mark in the United States, including all market. research, manufacturing activities, steps taken to acquire distributors, and steps taken to obtain required governmental approval.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 30** All documents referring or relating to communications between Respondent and the National Association of Attorneys Generals regarding Respondent's intent to manufacture and sell products in connection with the ROUTE 66 Mark.



**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such documents contain Respondent’s proprietary and confidential information, they will be produced subject to the protective order in this case.

**REQUEST NO. 31** All documents consulted in the preparation of, or which are requested to be identified in, Respondent’s answers to Petitioner’s First Set of Interrogatories.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase “[a]ll documents” is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent hereby incorporates by reference and restates in their entirety the objections stated in its answer to Petitioner’s first set of interrogatories.

Subject to and without waiver of the foregoing specific objections and incorporated General Objections and Objections to Instructions and Definitions, Respondent will produce non-privileged, responsive documents in its possession or control. To the extent any such

documents contain Respondent's proprietary and confidential information, they will be produced subject to the protective order in this case

**REQUEST NO. 32** All documents relating to any document retention policy of Respondent or the destruction of documents by Respondent at any time.

**RESPONSE:** In addition to the incorporated General Objections and Objections to Instructions and Definitions, Respondent objects to this request to the extent that it seeks the production of documents and things that are protected from disclosure by the attorney-client privilege and/or work product doctrine. Use of the phrase "[a]ll documents" is unreasonably vague, general, and overbroad and, as such, Respondent objects to this request as burdensome and oppressive. Respondent also objects to this request because it does not contain appropriate time restrictions on the period for which it seeks documents. In addition, Respondent objects to this request because it is not confined to the United States.

Respectfully submitted,

s/Brewster Taylor  
Brewster Taylor  
STITES & HARBISON, PLLC  
1199 North Fairfax Street  
Suite 900  
Alexandria, VA 22314  
Telephone: (703) 739-4900  
Email: [btaylor@stites.com](mailto:btaylor@stites.com)

Counsel for Respondent  
VAN NELLE TABAK NEDERLAND, BV

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Responses to Petitioner's First Set of Interrogatories is being mailed via first class mail, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 28th day of July 2008.

s/Brewster Taylor /  
\_\_\_\_\_  
Brewster Taylor

# **EXHIBIT D**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, L.P.,	)	
	)	
Petitioner,	)	Consolidated Cancellation No. 92048989
	)	
VAN NELLE TABAK NEDERLAND BV,	)	
	)	
Respondent.	)	

**PETITIONER'S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Petitioner Top Tobacco, L.P. hereby requests that Respondent Van Nelle Tabak Nederland BV serve upon Petitioner's attorneys sworn answers to the interrogatories set forth below within thirty (30) days after the service hereof. These interrogatories are intended to be continuing in nature and any information which may be discovered subsequent to the service of Respondent's initial answers should be brought to the attention of Petitioner through supplemental answers, within thirty (30) days following such discovery.

A. Definitions

As used herein, the words and phrases set out below shall have the meaning or meanings prescribed for them:

1. The term "Petitioner" shall mean petitioner Top Tobacco, L.P., as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

2. The term "Respondent" shall mean respondent Van Nelle Tabak Nederland BV, as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

3. The term "person" shall mean any individual, firm, partnership, corporation, proprietorship, association, or other organization or entity.

4. The term "identify" shall mean:

- (a) in connection with natural persons, state their full names, titles and job descriptions, if applicable, and their present or last known business and home addresses;
- (b) in connection with firms, partnerships, corporations, proprietorships, associations or other entities, state their name, and each of their present or last known addresses;
- (c) in connection with documents, describe the documents, setting forth their dates, titles, authors, addresses, parties thereto and the substance thereof, with such reasonable particularity as would be sufficient to permit them to be sought by subpoenas duces tecum or under the provisions of Rule 34 of the Federal Rules of Civil Procedure. Documents to be identified shall include both documents in your possession, custody and control and all other documents of which you have knowledge;
- (d) in connection with oral statements and communications, (i) state when and where they were made; (ii) identify each of the makers and recipients thereof as well as all others present at the time such statement or communication was made; (iii) indicate the medium of communication; and (iv) state their substance.

5. The term "documents" shall mean any and all writings of any nature whatsoever or other means by which information is retained in retrievable form, as well as drafts and all non-identical copies thereof, including but not limited to memoranda, stenographic or handwritten notes, contracts, agreements, records, audio and video recordings, correspondence, communications, reports, studies, summaries, surveys, statistical compilations, minutes, charts, manuals, brochures, schedules, price lists, telegrams, teletypes, facsimiles, E-mail, signage, certificates of registration, labels, specimens, writings, sketches, and computer disks, and any other documents as defined in Rule 34 of the Federal Rules of Civil Procedure.

6. The term "ROUTE 66 Mark" shall mean any trademark used at any time by Respondent that comprises the term "Route 66," in whole or in part, including without limitation

the mark "ROUTE 66 & Design Mark"(Registration No. 1,686,628), "ROUTE 66 ORIGINAL & Design Mark" (Registration No. 2,950,896), "ROUTE 66 Mark" (Registration No. 3,328,623).

B. Instructions

1. The singular shall include the plural and the plural shall include the singular.

2. A masculine, feminine or neuter pronoun shall not exclude the other genders.

3. The terms "and" as well as "or" shall be construed disjunctively or conjunctively as necessary in order to bring within the scope of the interrogatory all responses which might otherwise be construed to be outside its scope.

4. These interrogatories are intended to be continuing in nature and any information which may be discovered subsequent to the service of Respondent's initial answers should be brought to the attention of Petitioner through supplemental answers, within thirty (30) days following such discovery.

5. All objections or answers to interrogatories which fail or refuse to fully respond to any interrogatory on the ground of any claim of privilege of any kind whatever shall:

- (a) state the nature of the claim of privilege;
- (b) state all facts relied upon in support of the claim of privilege or related thereto;
- (c) identify all documents related to the claim of privilege;
- (d) identify all persons having knowledge of any facts related to the claim of privilege; and
- (e) identify all events, transactions or occurrences related to the claim of privilege.

C. Interrogatories

1. State the full name of Respondent as well as the full name of all of its respective affiliated and/or controlled businesses, companies, and other entities and each of their

predecessors-in-interest, and for each, identify its principal(s) and, if applicable, its state and country of organization.

2. State the full name of each business, company, person, or other entity affiliated within Respondent that has at any time used the ROUTE 66 Mark in the United States in connection with cigarettes or any other product(s), and for each, identify its principal(s) and, if applicable, its state and country of organization.

3. Identify by common commercial name each product that Respondent markets, distributes, sells, or offers for sale, or intends to market, distribute, sell or offer for sale, under or in connection with the ROUTE 66 Mark, and with respect to each such product:

- (a) set forth the actual geographic scope of such use;
- (b) set forth the annual actual volume of sales of the product in both dollars and units per year;
- (c) identify the years of such use; and
- (d) identify the persons most knowledgeable of such use, as well as all documents relating thereto.

4. For each product identified in response to Interrogatory No. 3 identify the dates on which the ROUTE 66 Mark was first used or on which Respondent intends to first use the ROUTE 66 Mark: (i) anywhere in the United States and (ii) in interstate commerce.

5. Identify every promotional effort, advertisement, commercial, catalogue, and/or promotional piece by which for each product identified in response to Interrogatory No. 3 was, is or will be advertised and promoted in the United States, and the associated expenditure and date of publication and/or distribution for each such ad (including production and media buys).

6. Identify every trade show at which each product identified in response to Interrogatory No. 3 has been or will be advertised and/or promoted, including the date and location of such trade show.



7. Identify each package or label designer, advertising agency, market research expert or consultant who has performed or will perform services in connection with cigarettes or any other product(s) promoted or sold by Respondent under or in connection with the ROUTE 66 Mark, and, for each such entity, describe in detail the services performed and the inclusive dates of such services.

8. State whether Respondent or any entity identified in Interrogatory Nos. 1 or 2 has ever objected to the use or registration of any other mark comprising the designation ROUTE 66, and if so, with respect to each such objection, identify the mark or designation to which the objection was made, the date of the objection, the user thereof, the nature of the objection, the disposition of the objection, the persons most knowledgeable of the objection, and all documents relating to the objection.

9. Identify by title, index number and tribunal each civil action or *inter partes* proceeding in which Respondent or any business, company or other entity identified in response to Interrogatory Nos. 1 or 2 has been or is involved, other than the present cancellation proceeding, that refers or relates in any way to any ROUTE 66 designation, setting forth the disposition of each such proceeding or, if not disposed of, its current status.

10. Identify all agreements to which Respondent or any business, company, or other entity identified in response to Interrogatory Nos. 1 or 2 has been or is a party that refer or relate in any way to any ROUTE 66 designation, including all amendments and modifications thereto, and identify the persons most knowledgeable thereof and all documents relating thereto.

11. Explain the reason(s) for Respondent's selection and adoption of its ROUTE 66 Mark, and identify all persons who participated in each such decisions as well as all documents relating thereto.

12. Identify the actual or intended wholesale and retail price at which all products bearing a ROUTE 66 Mark are or will be sold in the United States, and identify those persons who participated in all decisions regarding the setting of these prices.

13. Explain Respondent's reasons for allowing the ROUTE 66 & Design Mark, Registration No. 1,686,628, to go abandoned.

14. Describe the bases for Respondent's belief that it has not abandoned the ROUTE 66 Mark in the United States.

15. State whether Respondent has ever stopped manufacturing, distributing, advertising, or selling cigarettes or any other product under the ROUTE 66 Mark in the United States over the past five years, and, if so, identify the product, the time period and duration of the period in which the product was not manufactured, distributed, advertised or sold under the ROUTE 66 Mark and the reasons thereof.

16. For each period of time identified in Interrogatory No. 16 identify all efforts by Respondent to resume use of the ROUTE 66 Mark in the United States.

17. For each ROUTE 66 Mark ever used by Respondent in the United States: (i) identify any period of time in which Respondent made no sales of products bearing that mark in the United States, and (ii) identify any sales of products bearing that mark that were made by Respondent thereafter.

18. For each ROUTE 66 Mark ever used by Respondent in the United States identify any period(s) of non-use where Respondent did not use that mark for thirty days.

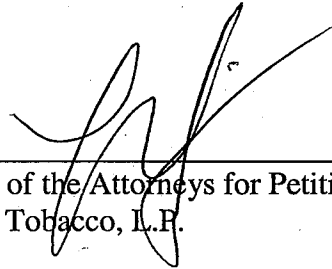
19. Identify the person(s) with the most knowledge and information concerning the responses to Interrogatory Nos. 17, 18, 19, and 20.

20. Identify the person(s) with the most knowledge and information concerning the prosecution of Application Serial Nos. 76/487,927 and 77/105,156.

21. Identify, on an interrogatory-by-interrogatory basis, each person furnishing information upon which any part of any answer to these interrogatories is based, indicating the parts based on information so furnished by each such person, and whether such information is within the personal knowledge of such person, and if not within such person's knowledge, identify the source of the information so furnished.

Dated: June 23, 2008

Respectfully submitted,



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One of the Attorneys for Petitioner,  
Top Tobacco, L.P.

Antony J. McShane  
Lara V. Hirshfeld  
Gregory Leighton  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street  
Suite 2200  
Chicago, Illinois 60602  
(312) 269-8000

**CERTIFICATE OF SERVICE**

I, Lara V. Hirshfeld, an attorney, state that I served a true and correct copy of Petitioner's

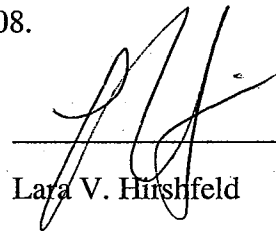
First Set of Interrogatories, upon:

Brewster Taylor  
STITES & HARBISON, PLLC  
Suite 900 1199 North Fairfax Street  
Alexandria, VA 22314-1437

Amy Cahill  
STITES & HARBISON, PLLC  
400 W. Market Street, Suite 1800  
Louisville, KY 40202-3352

by Email and First Class Mail on this 23rd day of June, 2008.

NGEDOCs: 1513322.2

  
\_\_\_\_\_  
Lara V. Hirshfeld

# **EXHIBIT E**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**TOP TOBACCO, L.P.,**

**Petitioner,**

**v.**

**VAN NELLE TABAK NEDERLAND, BV,**

**Respondent.**

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**Cancellation No. 92048989**

**ANSWER TO PETITIONER'S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Respondent Van Nelle Tabak Nederland, BV ("Respondent") responds and objects to the first set of interrogatories propounded by Petitioner Top Tobacco, L.P. ("Petitioner") as follows:

**GENERAL OBJECTIONS**

1. Respondent provides these responses based on its current knowledge and information that has been collected and reviewed to respond to these interrogatories. Pursuant to Federal Rule of Civil Procedure 26(e), Respondent reserves the right to supplement or revise its discovery responses.

2. Respondent's responses and objections are hereby made without waiver of, and intentional preservation of:

(a) All questions as to the competence, relevance, materiality, and admissibility as evidence for any purpose, of the responses or the subject matter thereof, in any aspect of this or any other court action or judicial or administrative proceedings or investigation;

(b) The right to object on any ground to the use of said responses, or to the subject matter thereof, in any aspect of this or any other

court action or judicial or administrative proceedings or investigation; and

- (c) The right to object on any ground at any time to other interrogatories, requests for production, requests for admission, or other discovery procedures involving or relating to the subject matter of these interrogatories.

3. Respondent is responding to Petitioner's interrogatories, and each interrogatory therein, as it interprets and understands that interrogatory with respect to the issues framed in connection with this proceeding. If Petitioner asserts an interpretation of any part of the interrogatory that differs from the understanding of Respondent, Respondent reserves the right to supplement or amend its responses and objections.

4. Respondent objects to each instruction, definition, and interrogatory to the extent it purports to impose any requirement or discovery obligation on Respondent greater or different from those imposed by the Federal Rules of Civil Procedure, the Trademark Rules of Practice, the discovery schedule in this case, or any other schedule or ruling that may be set forth by the Trademark Trial and Appeal Board, or other applicable rule or statute.

5. Respondent objects to each instruction, definition, and interrogatory to the extent it seeks information protected from disclosure by the attorney-client privilege, work product doctrine, or any other applicable privilege or immunity, including any applicable right of privacy.

6. Respondent objects to each instruction, definition, and interrogatory to the extent it calls for a privilege log with greater or different requirements from those prescribed by the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

7. Respondent objects to any request to identify privileged information, documents, or things generated after the filing date of this proceeding. Such material is privileged, and it is unduly burdensome to require the inclusion of any such material in any privilege log. Respondent does not waive any applicable privilege by inadvertent production of any privileged information.

8. Respondent objects to terms and phrases defined or used by Petitioner to the extent those terms and/or phrases are vague and/or ambiguous or beyond their customary meaning. To the extent Respondent adopts any terms or phrases defined or used by Petitioner, they are adopted solely for the sake of convenience in responding to these interrogatories, and Respondent does not accept or concede that any of the terms, phrases or definitions are appropriate, descriptive or accurate.

9. Respondent objects to each interrogatory to the extent that it seeks publicly available information that is equally available to Petitioner.

10. Respondent objects to each interrogatory to the extent it is overbroad in that it seeks information that is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence relevant to the subject matter of this proceeding. Any inadvertent production of information not related to the subject matter of this litigation does not waive this objection.

11. Respondent objects to each interrogatory to the extent it is unduly burdensome insofar as it may be construed to require Respondent to compile



information no longer available or to require Respondent to make an unduly burdensome search for information.

12. Respondent objects to each interrogatory to the extent it covers information and/or documents outside the possession, custody or control of Respondent.

13. In addition to these General Objections, Respondent has specific objections to certain definitions, instructions, and interrogatories as set forth below. Respondent does not waive any of these General Objections that may also be applicable to a specific interrogatory.

14. Respondent objects on the basis that the scope of the interrogatories violates the requirements of Federal Rule of Civil Procedure 26(g).

15. By making certain general and specific objections, Respondent does not waive other objections that might be applicable or become applicable at some time in the future. Respondent expressly reserves the right to assert additional objections which may become apparent in the course of producing information, documents, or things.

### **OBJECTIONS TO DEFINITIONS**

1. Respondent objects to the defined term "Petitioner" to the extent it includes the phrase "as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees" as being vague, ambiguous and overly broad as Petitioner fails to identify or to give Respondent notice of the identity of Petitioner's predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

2. Respondent objects to the defined term "Respondent" to the extent Petitioner seeks to include within the penumbra of this definition any person or entity

that is not properly within Respondent's control or any other person or entity that is not involved in and otherwise has no connection to this proceeding, rendering Petitioner's interrogatories overly broad, unduly burdensome, irrelevant, and not likely to lead the discovery of admissible evidence.

3. Respondent objects to the defined term "person" in that it is overly broad and unduly burdensome and also to the extent that it exceeds the requirements for answering an interrogatory under Federal Rule of Civil Procedure 33.

4. Respondent objects to the defined term "identify" to the extent Petitioner seeks to add multiple, additional subparts to its interrogatories that exceed the allowable limit under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice, to the extent it renders Petitioner's interrogatories voluminous and overly burdensome, and to the extent it exceeds the requirements for answering an interrogatory under Federal Rule of Civil Procedure 33.

5. Respondent objects to the defined term "documents" to the extent Petitioner seeks to broaden the definition of "documents" provided by the Federal Rules of Civil Procedure, to the extent Petitioner seeks documents no longer in Respondent's possession, custody, or control, to the extent the definition seeks to include drafts or other preliminary versions of documents which are neither relevant nor likely to lead to the discovery of admissible evidence, and to the extent Petitioner seeks documents protected from disclosure by the attorney-client privilege, work product doctrine, or are otherwise immune from discovery.

## **OBJECTIONS TO INSTRUCTIONS**

1. Respondent objects to Instruction No. 4 to the extent it exceeds or is otherwise inconsistent with the obligations to supplement discovery responses under the Federal Rules of Civil Procedure.

2. Respondent objects to Instruction No. 5 to the extent it calls for a privilege log with greater or different requirements from those prescribed by the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

## **INTERROGATORIES**

**INTERROGATORY NO. 1:** State the full name of Respondent as well as the full name of all of its respective affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest, and for each, identify its principal(s) and, if applicable, its state and country of organization.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it seeks information concerning Respondent's "affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest" that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to a relevant time period, and to the extent it is not confined to the United States. Respondent also objects to this interrogatory as being vague with respect to the term "principal(s)." In addition, Respondent objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories

for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that Van Nelle Tabak Nederland BV was incorporated in the Netherlands on April 3, 1998. Respondent will also will produce non-privileged documents sufficient for Petitioner to ascertain further information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 2:** State the full name of each business, company, person, or other entity affiliated within Respondent that has at any time used the ROUTE 66 Mark in the United States in connection with cigarettes or any other product(s), and for each, identify its principal(s) and, if applicable, its state and country of organization.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period. Respondent also objects to this interrogatory as being vague with respect to the phrase “affiliated within Respondent.” In addition, Respondent objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states it has used the ROUTE 66 Mark in the United States in advertising and in commercial testing and research. Respondent states further that one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Respondent otherwise claims no use of the ROUTE 66 Mark on packaging for cigarettes sold in the United States since February 6, 2003.

**INTERROGATORY NO. 3:** Identify by common commercial name each product that Respondent markets, distributes, sells, or offers for sale, or intends to market, distribute, sell or offer for sale, under or in connection with the ROUTE 66 Mark, and with respect to each such product:

- (a) set forth the actual geographic scope of such use;
- (b) set forth the annual actual volume of sales of the product in both dollars and units per year;
- (c) identify the years of such use; and
- (d) identify the persons most knowledgeable of such use, as well as all documents relating thereto.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the

allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Respondent otherwise claims no use of the ROUTE 66 Mark on packaging for cigarettes sold in the United States since February 6, 2003. Respondent states that future use may be in relation to any of the goods covered by U.S. Reg. No. 2,950,896 and U.S. Reg. No. 3,328,623. Moreover, with respect to future use, Respondent states as follows:

- (a) Respondent intends to sell ROUTE 66 products throughout the United States. However, it is likely that the brand would be launched regionally first to identify any marketing revisions to be considered before expanding nationally.
- (b) Not applicable.
- (c) Not applicable.
- (d) Tim Jones, Bill Melton, and Graham Bolt.

**INTERROGATORY NO. 4:** For each product identified in response to Interrogatory No. 3 identify the dates on which the ROUTE 66 Mark was first used or on which Respondent intends to first use the ROUTE 66 Mark: (i) anywhere in the United States and (ii) in interstate commerce.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant

time period. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that the ROUTE 66 Mark has been used on the Internet since at least as early as February 1, 2003, and has been used in commercial testing and research in the United States in 2006. In addition, one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Respondent otherwise claims no use of the ROUTE 66 Mark on packaging for cigarettes sold in the United States since February 6, 2003. No decision has been made regarding the specific future launch date for ROUTE 66 products in the United States.

**INTERROGATORY NO. 5:** Identify every promotional effort, advertisement, commercial, catalogue, and/or promotional piece by which for each product identified in response to Interrogatory No. 3 was, is or will be advertised and promoted in the United States, and the associated expenditure and date of publication and/or distribution for each such ad (including production and media buys).

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of

interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 6:** Identify every trade show at which each product identified in response to Interrogatory No. 3 has been or will be advertised and/or promoted, including the date and location of such trade show.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that the ROUTE 66 brand has not been advertised or promoted at any trade shows in the United States since the date of filing the application which issued as U.S. Registration No. 2,950,896 i.e. February 6, 2003. Once the brand is launched, Respondent



anticipates advertising and promoting the ROUTE 66 brand at NACS, AWMA, RTDA, NATO as well as wholesaler/distributor shows.

**INTERROGATORY NO. 7:** Identify each package or label designer, advertising agency, market research expert or consultant who has performed or will perform services in connection with cigarettes or any other product(s) promoted or sold by Respondent under or in connection with the ROUTE 66 Mark, and, for each such entity, describe in detail the services performed and the inclusive dates of such services.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it is not confined to the relevant time period and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory as being vague with respect to the phrase "market research expert or consultant". Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 8:** State whether Respondent or any entity identified in Interrogatory Nos. 1 or 2 has ever objected to the use or registration of any

other mark comprising the designation ROUTE 66, and if so, with respect to each such objection, identify the mark or designation to which the objection was made, the date of the objection, the user thereof, the nature of the objection, the disposition of the objection, the persons most knowledgeable of the objection, and all documents relating to the objection.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it seeks information concerning objections that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to the relevant time period, and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that it is not aware of any such objections.

**INTERROGATORY NO. 9:** Identify by title, index number and tribunal each civil action or *inter partes* proceeding in which Respondent or any business, company or other entity identified in response to Interrogatory Nos. 1 or 2 has been or is involved, other than the present cancellation proceeding, that refers or relates in any

way to any ROUTE 66 designation, setting forth the disposition of each such proceeding or, if not disposed of, its current status.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it seeks information concerning actions or proceedings that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to the relevant time period, and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that it is not aware of any such actions or proceedings.

**INTERROGATORY NO. 10:** Identify all agreements to which Respondent or any business, company, or other entity identified in response to Interrogatory Nos. 1 or 2 has been or is a party that refer or relate in any way to any ROUTE 66 designation, including all amendments and modifications thereto, and identify the persons most knowledgeable thereof and all documents relating thereto.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead

to the discovery of admissible evidence to the extent that it seeks information concerning agreements that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to the relevant time period, and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 11:** Explain the reason(s) for Respondent's selection and adoption of its ROUTE 66 Mark, and identify all persons who participated in each such decisions as well as all documents relating thereto.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence because it seeks information that is not even reasonably related or relevant to any issue in this proceeding, because it is not confined to the relevant time period, and because it is not restricted to the United States. In addition, Respondent objects to this interrogatory to the extent because it seeks information that is protected from disclosure by the attorney-client privilege and/or

work product doctrine. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 12:** Identify the actual or intended wholesale and retail price at which all products bearing a ROUTE 66 Mark are or will be sold in the United States, and identify those persons who participated in all decisions regarding the setting of these prices.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it is not confined to the relevant time period. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that there is no currently determined wholesale and retail price at which all products bearing a ROUTE 66 Mark are sold in the United States. Respondent is unable to

predict the future price at which all products bearing a ROUTE 66 Mark will be sold in the United States. However, it is anticipated that the price will most likely be at “generic level” e.g. the current generic price for cigarettes is roughly \$25.44 per carton.

**INTERROGATORY NO. 13:** Explain Respondent’s reasons for allowing the ROUTE 66 & Design Mark, Registration No. 1,686,628, to go abandoned.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence because it seeks information concerning the ROUTE 66 & Design Mark, Registration No. 1,686,628, that is not relevant to any issue in this proceeding. Respondent further objects to this interrogatory because it is improperly based on the legal conclusion that Respondent decided to abandon the mark.

**INTERROGATORY NO. 14:** Describe the bases for Respondent’s belief that it has not abandoned the ROUTE 66 Mark in the United States.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory because it seeks information that is protected from disclosure by the attorney-client privilege and/or work product doctrine. Respondent also objects to this interrogatory because it calls for legal conclusions or presents questions of law. Subject to and without waiver of the foregoing objections, Respondent refers Petitioner to its previous answers and advises that it will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

**INTERROGATORY NO. 15:** State whether Respondent has ever stopped manufacturing, distributing, advertising, or selling cigarettes or any other product under the ROUTE 66 Mark in the United States over the past five years, and, if so, identify the product, the time period and duration of the period in which the product was not manufactured, distributed, advertised or sold under the ROUTE 66 Mark and the reasons thereof.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that it has not “stopped manufacturing, distributing, advertising, or selling cigarettes or any other product under the ROUTE 66 Mark in the United States over the past five years”.

**INTERROGATORY NO. 16:** For each period of time identified in Interrogatory No. 16 identify all efforts by Respondent to resume use of the ROUTE 66 Mark in the United States.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as vague, indefinite, and incapable of a meaningful response to the extent it seeks information about “each period of time identified in Interrogatory No. 16.”

Respondent responds to this interrogatory as if it refers to Interrogatory No. 15.

Respondent further objects to this interrogatory as being vague with respect to the term "efforts."

Subject to and without waiver of the foregoing objections, Respondent states that this interrogatory is not applicable in view of its Answer to the preceding interrogatory.

**INTERROGATORY NO. 17:** For each ROUTE 66 Mark ever used by Respondent in the United States: (i) identify any period of time in which Respondent made no sales of products bearing that mark in the United States, and (ii) identify any sales of products bearing that mark that were made by Respondent thereafter.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence because it seeks information that is not even reasonably related or relevant to any issue in this proceeding. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that this interrogatory is not applicable in view of its Answers to the preceding interrogatories.



**INTERROGATORY NO. 18:** For each ROUTE 66 Mark ever used by

Respondent in the United States identify any period(s) of non-use where Respondent did not use that mark for thirty days.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence because it seeks information that is not even reasonably related or relevant to any issue in this proceeding. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent that this interrogatory is not applicable in view of its Answers to the preceding interrogatories.

**INTERROGATORY NO. 19:** Identify the person(s) with the most

knowledge and information concerning the responses to Interrogatory Nos. 17, 18, 19, and 20.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as vague, indefinite, and incapable of a meaningful response to the extent it seeks information about Interrogatory Nos. 19 and 20. Respondent responds to this interrogatory as if it refers to Interrogatory Nos. 15, 16, 17 and 18. Respondent also objects to this interrogatory to the extent that it seeks information that is protected from

disclosure by the attorney-client privilege and/or work product doctrine. Respondent further objects to this interrogatory as compound and containing multiple subparts.

Subject to and without waiver of the foregoing objections, Respondent identifies the following persons: Tim Jones, Bill Melton, and Graham Bolt.

**INTERROGATORY NO. 20:** Identify the person(s) with the most knowledge and information concerning the prosecution of Application Serial Nos. 76/487,927 and 77/105,156.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory to the extent that it seeks information that is protected from disclosure by the attorney-client privilege and/or work product doctrine. Respondent further objects to this interrogatory as compound and containing multiple subparts.

Subject to and without waiver of the foregoing objections, Respondent identifies Graham Bolt in connection with Application Serial No. 76/487,927. Respondent identifies Graham Bolt, Tim Jones, and Bill Melton in connection with Application Serial No. 77/105,156.

**INTERROGATORY NO. 21:** Identify, on an interrogatory-by-interrogatory basis, each person furnishing information upon which any part of any answer to these interrogatories is based, indicating the parts based on information so furnished by each such person, and whether such information is within the personal knowledge of such person, and if not within such person's knowledge, identify the source of the information so furnished.

**ANSWER:** In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory to the extent that it seeks information that is protected from disclosure by the attorney-client privilege and/or work product doctrine. Respondent further objects to this interrogatory as compound and containing multiple subparts.

Subject to and without waiver of the foregoing objections, Respondent identifies Tim Jones, Bill Melton, and Graham Bolt.

Respectfully submitted,

s/Brewster Taylor

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Counsel for Respondent  
VAN NELLE TABAK NEDERLAND, BV

**VERIFICATION**

I, Trevor Williams, verify that I am currently the assistant company secretary of Imperial Tobacco Limited; that I am hereby signing the Answer to Petitioner's First Set of Interrogatories, and I am authorized to do so; that the matters stated therein are not all within my personal knowledge; that I am informed that there is no single person at Van Nelle Tabak Nederland, BV ("Respondent") who has personal knowledge of all such matters; that the facts stated therein have been assembled by employees of Imperial Tobacco Group or its subsidiaries (including the Respondent) and counsel for Respondent; and to the best of my present knowledge and information, believe that the facts so stated are true and accurate.

I declare, under penalty of perjury that the foregoing is true and accurate.

Date: \_\_\_\_\_

\_\_\_\_\_  
Trevor Williams

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Answer to Petitioner's First Set of Interrogatories is being mailed via first class mail, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 28th day of July 2008.

s/Brewster Taylor /

Brewster Taylor

# **EXHIBIT F**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of  
Registration Nos. 1,686,628, 2,950,896, and  
3,328,623

TOP TOBACCO, LP,

Petitioner,

v.

VAN NELLE TABAK NEDERLAND BV,

Respondent.

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CONSOLIDATED PETITION TO  
CANCEL

CONSOLIDATED PETITION TO CANCEL

This Consolidated Petition to Cancel is submitted in the matter of Registration Nos. 1,686,628, 2,950,896, and 3,328,623 all of which are owned by Van Nelle Tabak Nederland BV, located at Slachtedyk 28A, 8501 Za Joure, Netherlands. Registration No. 1,686,628 issued on May 12, 1992 for the mark ROUTE 66 & Design in connection with cigarettes and lighters in International Class 34. Registration No. 2,950,896 issued on May 17, 2005 for the mark ROUTE 66 ORIGINAL & Design in connection with tobacco whether manufactured or unmanufactured; tobacco products, namely, hand-rolling tobacco, cigars, cigarettes; tobacco substitutes, none being for medicinal or curative purposes; smokers' articles, namely, cigarette lighters not of precious metal, ashtrays not of precious metal, cigarette papers, matches in International Class 34. Registration No. 3,328,623 issued on November 6, 2007 for the mark ROUTE 66 in connection with cigarettes, cigars, cigarillos, tobacco, matches, lighters and ashtrays not made of precious metals, pipes, tobacco cases not made of precious metals, cigarette papers, cigarette

filters, cigarette tubes, and hand-held machines for rolling and making cigarettes in International Class 34. Top Tobacco, LP, a Delaware limited partnership with a place of business at 2301 Ravine Way Glenview Illinois 60025 ("Top Tobacco"), believes that it will be injured by the continued registration of Registration Nos. 1,686,628, 2,950,896, and 3,328,623 and, therefore, petitions to cancel the same on the following grounds:

1. For many years, Top Tobacco, its predecessors and affiliates have been engaged, *inter alia*, in the manufacture, distribution and sale of smoker's articles, including, cigarette rolling papers, smoking tobacco, filter tubes and cigarette machines. Top Tobacco distributes its products through tobacco shops, drugstores, tobacco outlets, novelty, convenience and other retail stores, as well as through select restaurants and clubs. As a result, Top Tobacco has become one of the best-known manufacturers of tobacco and tobacco-related products in the United States.

2. Top Tobacco has applied for federal registration of the trademark ROUTE 66 in connection with cigarette making machines in International Class 7, and tobacco, cigarette papers, cigarette filters, cigarette tubes, cigarette rolling machines, cigarette injecting machines, and kits for making cigarettes in International Class 34, Serial No. 77/393,701.

3. On information and belief, Respondent is a corporation incorporated under the laws of the country of the Netherlands. On information and belief, *inter alia*, Respondent manufactures roll-your-own and pipe tobaccos and markets and sells tobacco products in the Netherlands and in other countries.

4. On May 12, 1992, Registration No. 1,686,628 (the "628 Registration") issued to Andre` and Mairade Ann Levy for the mark ROUTE 66 & Design for use in connection with beer, ale, lager, stout, shandy, soft drinks, syrups and concentrates for



making soft drinks; and fruit juices in International Class 32; cigarettes, cigars, cigarillos, smoking tobacco, chewing tobacco, snuff, matches, lighters, ashtrays, pipes, tobacco cases not of precious metal and cigarette papers in International Class 34. The '628 Registration was based on Section 44(d) of the Trademark Act. On January 12, 1998, Andre` and Mairade Ann Levy assigned their entire interest to the ROUTE 66 & Design mark and the '628 Registration to Navigator, Inc.

5. Upon filing its Section 8 Declaration for the '628 Registration, Navigator, Inc. canceled the registration for International Class 32 goods, and deleted all of the International Class 34 goods with the exception of cigarettes and lighters.

6. On March 7, 2000, Navigator, Inc. assigned the entire interest to the ROUTE 66 & Design mark to Respondent.

7. On May 17, 2005, Registration No. 2,950,896 (the "'896 Registration") issued to Respondent for the mark ROUTE 66 ORIGINAL & Design for use in connection with tobacco whether manufactured or unmanufactured, tobacco products, namely, hand-rolling tobacco, cigars, cigarettes, tobacco substitutes, none being for medicinal or curative purposes, smokers' articles, namely, cigarette lighters not of precious metal, ashtrays not of precious metal, cigarette papers, matches in International Class 34. The '896 Registration is based upon Section 44(d) of the Trademark Act; Respondent has not alleged use of the mark in connection with the '896 Registration.

8. On November 6, 2007, Registration No. 3,328,623 (the "'623 Registration") issued to Respondent for the mark ROUTE 66 for use in connection with cigarettes, cigars, cigarillos, tobacco, matches, lighters and ashtrays not made of precious metals, pipes, tobacco cases not made of precious metals, cigarette papers, cigarette filters, cigarette tubes, and hand-held machines for rolling and making cigarettes in

International Class 34. The '623 Registration was based upon Section 44(e) of the Trademark Act; Respondent has not alleged use of the mark in connection with the '896 Registration.

9. On information and belief, subsequent to the issuance of Registration No. 1,686,628, and long prior to the filing of the applications that resulted in Registration Nos. 2,950,896, and 3,328,623, Respondent discontinued use in the United States of the mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future. Moreover, on information and belief, Respondent has not used the '896 and '623 Registrations, which are based on foreign registrations, during the period between the dates of registration and the filing of this Petition, and such non-use of the marks in commerce is not excusable non-use. Therefore, on information and belief, Respondent has abandoned the registered ROUTE 66 & Design, ROUTE 66 ORIGINAL & Design or ROUTE 66 marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127, and has not complied with the requirements of Section 44 of the Trademark Act, 15 U.S.C. § 1126.

10. Accordingly, Registration Nos. 1,686,628, 2,950,896, and 3,328,623 should be cancelled in accordance with Section 14 of the Trademark Act, 15 U.S.C. § 1064.

11. Respondent's continued registration of the ROUTE 66 & Design, ROUTE 66 ORIGINAL & Design, and ROUTE 66 marks, would likely result in damage and injury to Top Tobacco in that it is likely to cause confusion, or to cause mistake, or to deceive with respect to Top Tobacco's ROUTE 66 mark.

WHEREFORE, Top Tobacco requests that Registration Nos. 1,686,628, 2,950,896, and 3,328,623 be canceled and that this Consolidated Petition for Cancellation be granted.

Petitioner requests that the requisite filing fee be charged to the deposit account of Neal, Gerber & Eisenberg, Account No. 502261.

Please address all communications relating to this matter to Antony J. McShane, Lara V. Hirshfeld, and Gregory J. Leighton, Neal, Gerber & Eisenberg, Two North LaSalle Street, Chicago, Illinois 60602-3801.

Respectfully submitted,

Date: March 6, 2008

By: /Antony J. McShane/  
One of the Attorneys for  
Top Tobacco, LP

Antony J. McShane  
Lara V. Hirshfeld  
Gregory J. Leighton  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street  
Chicago, Illinois 60602-3801  
(312) 269-8000

CERTIFICATE OF SERVICE

I, Lara V. Hirshfeld, an attorney, state that I served a copy of the foregoing CONSOLIDATED PETITION TO CANCEL upon:

BREWSTER TAYLOR  
STITES & HARBISON, PLLC  
1199 NORTH FAIRFAX STREET, SUITE 900  
ALEXANDRIA, VA 22314-1437

via U.S. Mail on this 6<sup>th</sup> day of March 2008.

/Lara V. Hirshfeld/  
Lara V. Hirshfeld

# **EXHIBIT G**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of**  
**Registration Nos. 1,686,628, 2,950,896, and**  
**3,328,623**

**TOP TOBACCO, LP**

**Petitioner,**

**v.**

**VAN NELLE TABAK NEDERLAND BV,**

**Respondent.**

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**Cancellation No. 92048989**

**ANSWER TO CONSOLIDATED PETITION TO CANCEL**

Pursuant to 37 C.F.R. § 2.114, **VAN NELLE TABAK NEDERLAND BV** (hereinafter “Respondent”), a corporation of the Netherlands with principal offices located at Slachtedijk 28A 8501 Za Joure, Netherlands, hereby answers the Consolidated Notice of Cancellation filed by Petitioner, **TOP TOBACCO, LP** (hereinafter “Petitioner”), as follows:

Respondent admits the statements made in the preamble of the Consolidated Petition for Cancellation except that it denies that Registration No. 1,686,628 issued for the mark “ROUTE 66” plus design only for “cigarettes and lighters in International Class 34 and is without knowledge or information sufficient to form a belief as to the truth of the allegation that Petitioner believes that it will be injured by the continued registration of Registration Nos. 1,686,628, 2,950,896, and 3,328,623 and therefore denies the same.

1. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments of Paragraph 1 and therefore denies the same.
2. Respondent admits the averments of paragraph 2 except that it denies that Petitioner has accurately described the identification of goods in the application.
3. Respondent admits the averments of paragraph 3.
4. Respondent admits the averments of paragraph 4 except that Respondent denies that Registration No. 1,686,628 issued based on Section 44(d) of the Trademark Act.
5. Respondent admits the averments of paragraph 5 except that Respondent denies that Navigator, Inc. "canceled the registration for International Class 32 goods".
6. Respondent admits the averments of paragraph 6.
7. Respondent admits the averments of paragraph 7 except that Respondent denies that Registration No. 2,950,896 issued based on Section 44(d) of the Trademark Act.
8. Respondent admits the averments of paragraph 8.
9. Respondent denies the averments of paragraph 9.
10. Respondent denies the averments of paragraph 10.
11. Respondent denies the averments of paragraph 11.

**AFFIRMATIVE DEFENSES**

12. The Petition for Cancellation fails to state a claim upon which relief can be granted.
13. The Petition for Cancellation of U.S. Registration No. 1,686,628 is moot.

WHEREFORE, Respondent denies that Petitioner is entitled to the relief requested in its Consolidated Petition for Cancellation and requests that the Consolidated Petition for Cancellation be dismissed.

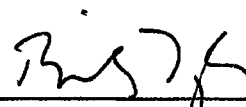
Respectfully Submitted,  
STITES & HARBISON, PLLC

  
\_\_\_\_\_  
Brewster Taylor

Transpotomac Plaza  
1199 North Fairfax Street  
Suite 900  
Alexandria, Virginia 22314  
(703) 739-4900  
**April 14, 2008**

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing ANSWER TO CONSOLIDATED PETITION TO CANCEL was *mailed via first class mail*, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, NEAL, GERBER & EISENBERG LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this the *14<sup>th</sup>* day of April 2008.

  
\_\_\_\_\_  
Brewster Taylor



# **EXHIBIT H**

August 27, 2008

**VIA EMAIL AND U.S. MAIL**

Brewster Taylor  
STITES & HARBISON, PLLC  
1199 North Fairfax Street  
Suite 900  
Alexandria, VA 22314

**Re: Top Tobacco, L.P. v. Van Nelle Tabak Nederland BV  
Cancellation No. 92048989**

Dear Brewster:

We write to address the deficiencies in Respondent's, Van Nelle Tabak Nederland BV, Responses to Petitioner's First Set of Interrogatories ("Interrogatories") and First Set of Requests for the Production of Documents ("Document Requests").

***Respondent's Objection to Petitioner's Definition of the term "ROUTE 66 Mark"***

First, we address Respondent's objection to Petitioner's definition of the term "ROUTE 66 Mark" in its Interrogatories and Document Requests. Specifically, Petitioner defined "ROUTE 66 Mark" as "any trademark used at any time by Respondent that comprises the term 'Route 66,' in whole or in part, including without limitation the mark 'ROUTE 66 & Design Mark' (Registration No. 1,686,628), 'ROUTE 66 ORIGINAL & Design Mark' (Registration No. 2,950,896), 'ROUTE 66 Mark' (Registration No. 3,328,623)." Respondent has objected to this definition as unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence apparently based on the inclusion of Registration No. 1,686,628. This objection is completely groundless, in view of Petitioner's allegations in its Petition to Cancel that "Respondent has discontinued use of the mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future," to which Respondent has denied. See Petition to Cancel, ¶ 9; Answer to Petition to Cancel, ¶ 9. Indeed, Petitioner is entitled to test the veracity of Respondent's claims and defenses, and in order to do so, it is essential that Petitioner obtain information and documents on all ROUTE 66 marks used in the United States by Respondent at any time – which includes any use of a ROUTE 66 mark prior to when Respondent filed its application to register the ROUTE 66 ORIGINAL & Design mark in February, 2003. Moreover, as you know, Respondent cited ownership of the '628 registration and Registration No. 2,422,437 – both of which were canceled due to Respondent's failure to use in the United States -- to the Examiner to support its prosecution of the applications that ultimately resulted in the '623 and '896 registrations. See, e.g., June 7, 2007 Response to Office Action, Application No. 77/105,156; October 16, 2003 Response to Office Action, Application No. 76/487,927. Therefore, these registrations and information concerning Respondent's use, if

Mr. Brewster Taylor

August 27, 2008

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any, of their subject marks is clearly relevant. Accordingly, Petitioner requests that Respondent withdraw its objection, supplement its responses to Interrogatory Nos. 2-7, 11-12, and 14-18, and confirm that the documents produced in response to Document Request Nos. 2-13, 18-26, and 29-30 will include documents related to any trademark used at any time by Respondent that comprises the term "Route 66," in whole or in part.

*Respondent's Responses to Interrogatories*

Respondent's responses to the Interrogatories suffer from the following deficiencies.

**Interrogatory No. 1:** This Interrogatory asks, among other things, for Respondent to "state the full name of Respondent as well as the full name of all of its respective affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest, and for each, identify its principal(s) and, if application, its state and country of organization." Respondent objected to this Interrogatory as "overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it seeks information concerning Respondent's 'affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest' that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to a relevant time period, and to the extent it is not confined to the United States." Respondent also objected to the use of the term "principal(s)" as vague. This Interrogatory is self-explanatory and relevant to the issues in this case, and directs Respondent to its own Interrogatory No. 15 which uses similar, if not the same, terms and seeks the same type of information from Petitioner.

Nonetheless, without conceding these objections, but in an effort to resolve the objections, Petitioner hereby limits Interrogatory No. 1 to all "affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest that has at any time used any ROUTE 66 designation in connection with tobacco or any other product(s), and for each, identify its principal(s) and, if application, its state and country of organization." Therefore, please provide a supplemental response to revised Interrogatory No. 1.

**Interrogatory No. 2:** This Interrogatory asks for Plaintiff to "state the full name of each business, company, person, or other entity affiliated [with] Respondent that has at any time used the ROUTE 66 Mark in the United States in connection with cigarettes or any other product(s), and for each, identify its principal(s) and, if applicable, its state and country of organization." In Response, Respondent identified Commonwealth Brands, Inc., and J.L. Gaddy Enterprises but failed to identify their principals and state and country of origin. Respondent also did not indicate how these two entities are affiliated with Respondent. Therefore, please provide this information in a supplemental response to Interrogatory No. 2.

**Interrogatories No. 3:** This Interrogatory asks Respondent to, among other things, "[i]dentify by common commercial name each product that Respondent markets, distributes, sells, or offers for sale, or intends to market, distribute, sell or offer for sale, under or in connection with the ROUTE 66 Mark, and with respect to each such product: (a) set forth the

Mr. Brewster Taylor

August 27, 2008

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actual geographic scope of such use." Respondent's response to this Interrogatory is incomplete because it fails to identify a single commercial name for any product, and instead vaguely states that Respondent shipped a case of cigarettes in ROUTE 66 packaging. Respondent's response is also incomplete because it does not identify the specific states it intends to sell ROUTE 66 products, but instead generally states it is likely to launch any ROUTE 66 brand "regionally" before expanding nationally. Therefore, please provide this information in Respondent's supplemental response to Interrogatory No. 3.

**Interrogatories No. 4:** This Interrogatory asks Respondent to "identify the dates on which the ROUTE 66 Mark was first used or on which Respondent intends to first use the ROUTE 66 Mark: (i) anywhere in the United States and (ii) in interstate commerce." Respondent vaguely responded that it has used ROUTE 66 since February 1, 2003 in commercial testing and research in the United States and that it shipped one case of cigarettes from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc on May 8, 2008. Please indicate where in the United States such testing and research took place and what states Commonwealth Brands, Inc. and JL Gaddy Enterprises, Inc. are located in Respondent's Supplemental Response to Interrogatory No. 4. Also, please confirm that Respondent has not used the ROUTE 66 Mark in interstate commerce or anywhere in the United States other than in these two instances both before and after May 8, 2008.

**Interrogatory No. 13:** This Interrogatory asks Plaintiff to "explain Respondent's reasons for allowing the ROUTE 66 & Design Mark, Registration No. 1,686,628, to go abandoned." Respondent refuses to provide a response to this Interrogatory because it wrongly claims that such information is not relevant to any issue in this proceeding. However, as explained above, this information is relevant to these proceedings as Petitioner alleges that Respondent has discontinued use of the mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future. See Petition to Cancel, ¶ 9. Please provide this information in Plaintiff's supplemental response to Interrogatory No. 13.

#### *Responses to Document Requests*

Respondent's responses to the Document Requests suffer from the following deficiencies:

**Document Request No. 16:** This Document Request seeks "all documents that disclose, describe, or otherwise related to the decision by Respondent or its affiliates, or their predecessors, to abandon the ROUTE 66 & Design Mark, Registration No. 1,686,628." Respondent refuses to provide responsive documents based on a litany of groundless objections, including that this Document Request is based on a legal conclusion that Respondent made a decision to abandon this mark and that this Document Request contains no time restrictions. As you know, it is not possible for Petitioner to determine the exact date that Respondent abandoned this mark based upon the publicly available information. Thus, Petitioner does not need to

Mr. Brewster Taylor

August 27, 2008

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include a specific date in this Document Request as Respondent is the only party that knows when and why this mark was abandoned.

Nonetheless, without conceding these objections, but in an effort to resolve the objections, Petitioner hereby revises Document Request No. 16 to "all documents that disclose, describe, or otherwise relate to the abandonment of the ROUTE 66 & Design Mark, Registration No. 1,686,628 after 1998." Please produce copies of all documents sought by revised Document Request No. 16.

**Document Request No. 17:** This Document Request seeks "all documents that disclose, describe, or otherwise relate to Application Serial Nos. 73/745,820, 76/487,927, and 77/105,156, including all communications with the United States Patent & Trademark Office." Respondent responded that it would produce documents relating to Application Serial Nos. 76/487,927, and 77/105,156. Please confirm that Respondent will also produce documents relating to Application Serial No. 73/745,820.

**Document Request No. 32:** This Document Request seeks "all documents relating to any document retention policy of Respondent or the destruction of documents by Respondent at any time." Respondent's objection and refusal to produce documents in response to this Document Request because it is not confined to the United States is particularly questionable considering that Respondent is located in the Netherlands. Respondent's objection that this Document Request does not contain time restrictions is equally questionable. Indeed, Respondent's document retention policy is directly relevant to identify what types of records Respondent keeps, and has kept, in the ordinary course of business related to its use of any ROUTE 66 mark in the United States. Thus, please produce the documents sought by this document request.

We look forward to your prompt response.

Sincerely,

  
Lara V. Klapper

cc: Antony J. McShane, Esq.  
Gregory Leighton, Esq.

NEAL ■ GERBER ■ EISENBERG

Lara V. Klapper  
Attorney at Law

Tel 312.269.5385  
Fax 312.980.0701  
lklapper@ngelaw.com

September 10, 2008

**VIA EMAIL AND U.S. MAIL**

Brewster Taylor  
STITES & HARBISON, PLLC  
1199 North Fairfax Street  
Suite 900  
Alexandria, VA 22314

**Re: Top Tobacco, L.P. v. Van Nelle Tabak Nederland BV**  
**Cancellation No. 92048989**

Dear Brewster:

We have not received a response to my August 27, 2008 letter regarding the deficiencies in Respondent's, Van Nelle Tabak Nederland BV, Responses to Petitioner's First Set of Interrogatories and First Set of Requests for the Production of Documents. We believe it is in the interest of all parties to resolve any discovery disputes with respect to these interrogatories and documents requests without intervention of the Board. Therefore, please promptly provide a response to my August 27<sup>th</sup> letter.

We look forward to hearing from you.

Sincerely,

  
Lara V. Klapper

cc: Antony J. McShane, Esq.

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Alexandria, VA 22314-1437  
[703] 739-4900  
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September 16, 2008

VIA MAIL AND EMAIL LKLAPPER@NGELAW.COM

Brewster Taylor  
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(703) 518-2936 FAX  
btaylor@stites.com

Lara V. Klapper  
Neal Gerber Eisenberg  
Two North LaSalle Street, Ste. 2200  
Chicago, Illinois 60602

RE: **Top Tobacco, L.P. v. Van Nelle Tabak Nederland BV;  
Cancellation No. 92048989**

Dear Ms. Klapper:

We are in receipt of your letter dated August 27, 2008 and respond to your points in turn below. In addition, we address the deficiencies in Petitioner's responses to Respondent's first set of discovery requests. Finally, please advise by return as to when and how Top Tobacco will provide documents in response to our requests. We would be glad to send our document production if you will agree to do the same.

**I. Respondent's Responses to Petitioner's Discovery Requests**

**Objection to Petitioner's Definition of the term "ROUTE 66 Mark"**

Petitioner sought to include in its definition of "ROUTE 66 Mark" the mark that is the subject of expired U.S. Registration No. 1,686,628. Respondent properly objected to this definition because it renders the discovery requests unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Contrary to the assertions in Petitioner's letter, Petitioner's claims are now limited only to cancellation of U.S. Trademark Registration Nos. 2,950,896 and 3,328,623 on the grounds of alleged abandonment of those marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127. Petitioner's claims in connection with the expired '628 registration are moot. (Board's Order, May 27, 2008.) Both of these registrations are based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126. Accordingly, the '628 registration and the subject matter thereof are completely irrelevant to Petitioner's claims:

The fact that applicant allowed its U.S. registration to expire does not establish an abandonment of its rights in the mark. **More importantly, however, is the fact that this is a new application and the circumstances surrounding applicant's prior application and resulting registration are of no consequence here.** A foreign national qualified under the provisions of Section 44(b), such as this

Lara V. Klapper  
September 16, 2008  
Page 2

applicant, seeking registration under Section 44(e) of the Act needs not allege or demonstrate use of the mark on or before the filing date of the U.S. application for registration.

*Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985) (emphasis added).

Moreover, the relevant timeframe with respect to Petitioner's abandonment claims begins when the '896 and '623 registrations actually issued. *Consolidated Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153, 1155 (TTAB 2002). Prior to these dates, there was a dispensation of use requirements in keeping with the Section 44(e) basis for Respondent's registrations. *Id.* (citing *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575 (Fed. Cir. 1990)). Thus, for all of the above reasons, Petitioner maintains its objections to the definition and to the discovery requests affected thereby.

Finally, the fact that registrations existed and were cited in connection with the prosecution of the applications which issued as the registrations at issue is irrelevant to the issue of whether the marks in the registrations at issue were abandoned after the issuance of the registrations.

#### Respondent's Interrogatory Responses

##### Interrogatory No. 1

Respondent renews its objections to this interrogatory. Petitioner's suggested limitation does not confine the interrogatory either to a relevant time period or to the United States. With respect to use in the United States, Respondent has identified in response to Interrogatory No. 2 the affiliated businesses which have used the "ROUTE 66" mark in the United States during the relevant time period.

##### Interrogatory No. 2

The address of Commonwealth Brands, Inc. is 900 Church Street, Bowling Green, Kentucky 42101. It is Applicant's sister company. I will obtain identification of relevant principals. JL Gaddy Enterprises, Inc. is located at 6002 Wylie Ave., Hickory Grove, South Carolina 29717-7759. I believe that JL Gaddy Enterprises, Inc. is affiliated only as a wholesaler of Respondent's products but will obtain confirmation and identification of relevant principals if available.



Lara V. Klapper  
September 16, 2008  
Page 3

Interrogatory No. 3

Respondent specifically identified the products that had been sold under the "ROUTE 66" mark in the U.S. since the registrations issued i.e. cigarettes and stated that future use may be in relation to any of the goods listed in the registrations. Respondent cannot identify the "specific states" in which it intends to sell "ROUTE 66" products because it has not yet determined the "specific states" in which the products will be sold. Though Respondent intends to sell "ROUTE 66" products nationwide, it will begin sales regionally. The scope of the region has not yet been determined. Further, Petitioner requested Respondent "set forth the actual geographic scope of such use," not "the specific states it intends to sell ROUTE 66 products." As stated above, the only sales since the registrations issued were to the wholesaler JL Gaddy Enterprises, Inc., which is located in South Carolina. As to intended use, Respondent's reply that it intends to sell ROUTE 66 products throughout the United States is fully responsive.

Interrogatory No. 4

Subject to our objections, this is to advise that the commercial testing took place in Minneapolis, Minnesota, and Birmingham, Alabama November 27 – 30, 2006 and in Atlanta, Georgia, and Cleveland, Ohio, December 11-14, 2006. Commonwealth Brands, Inc. is located in Kentucky, and JL Gaddy Enterprises, Inc. is located in South Carolina. The commercial testing and the sale to JL Gaddy Enterprises, Inc. are the only commercial uses of the mark in the U.S. since either registration issued. Respondent will produce non-privileged documents for Petitioner to ascertain further information regarding the commercial testing and research conducted in the United States in 2006.

Interrogatory No. 13

Respondent maintains its objections to this interrogatory and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark."

Respondent's Responses to Document Requests

Document Request No. 16

Respondent renews its objections to this revised request and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark." As is evident from the TTAB case quoted above, the objections are not "groundless".

Document Request No. 17

Respondent renews its objections and response to this request and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark."

Lara V. Klapper  
September 16, 2008  
Page 4

Document Request No. 32

Respondent maintains its objections to this request. Petitioner fails to appropriately limit this request, instead asking for "all documents," wherever located and whenever created. This request is clearly unreasonably vague, general, and overbroad, rendering the request burdensome and oppressive. However, I will ask if there are any documents which specifically relate to Respondent's document retention policy.

**II. Petitioner's Responses to Respondent's Discovery Requests**

In reviewing Petitioner's discovery responses thus far, we note the following deficiencies to be addressed.

Requests for Admission 6-16 and Interrogatories Nos. 5, 6, and 9

In response to these discovery requests, Petitioner has tendered variations of an unacceptable response that is convoluted and unintelligible. Specifically, Petitioner objects on the grounds these requests comprise "a legal impossibility, namely the existence of documents to prove the absence of a fact" and are premature because they involve information or documents in Respondent's possession. These requests specifically seek to elicit information regarding Petitioner's evidence, if any, in support of its claims of abandonment, *e.g.*, "Describe any evidence you have that supports the abandonment of Respondent's Marks." (Interrogatory No. 5.)

Petitioner initiated the current cancellation proceeding, averring that "on information and belief," Respondent had abandoned the subject marks. Now, Petitioner equivocates in response to direct inquiries regarding the substance of that information and belief. Petitioner has failed to reveal any source of information that formed the basis of its claims, now describing such information as "a legal impossibility" in contravention of its averments in the Petition to Cancel.

Further, to the extent Petitioner objects to these or other requests as premature because the requested information or documents are within Respondent's possession, Petitioner's responses are willfully deficient. Petitioner is obligated to provide responsive information and documents of which it is currently aware or to state it has no such information or documents. Respondent's requests are clearly not directed to discover information and documents in Respondent's possession.

Respondent requests that Petitioner withdraw its objections and supplement its responses to these discovery requests.

Petitioner's Responses to Interrogatories

Lara V. Klapper  
September 16, 2008  
Page 5

Interrogatory No. 11

Petitioner's response to Interrogatory No. 11 was limited to an objection "to the extent it seeks information protected by the attorney-client privilege and work product doctrine." This is a "yes" or "no" question. Please respond.

Interrogatory No. 12

Petitioner objected to this Interrogatory in part as irrelevant to the issues raised in Petitioner's Petition for Cancellation. To the contrary, this Interrogatory is directly relevant to Petitioner's claims of abandonment and as such, Respondent requests Petitioner withdraw its objections. Further, Petitioner's response vaguely refers to an investigation it performed regarding any possible use of Respondent's Marks in commerce in the United States. In Petitioner's supplemental response to this Interrogatory, please identify the investigation in accordance with the definition provided in the interrogatories.

Interrogatory No. 14

This Interrogatory requests Petitioner identify all plans to advertise, offer, or sell products using "ROUTE 66," all documents relating thereto, and the persons most knowledgeable thereof. Petitioner's response states only that it "intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the Route 66 mark in commerce in the United States" and identifies Seth Gold as the most knowledgeable person. Please clarify whether Petitioner has any more specific plans in connection with these products and also identify documents that relate to these plans or state that no such documents exist.

Interrogatory No. 19

This Interrogatory requests Petitioner identify those who have performed services in connection with products to be sold by Petitioner under or in connection with any ROUTE 66 designation and to "describe in detail the services performed and the inclusive dates of such services." In response, Petitioner identifies DRL Enterprises, Inc. and Steven Sandman, Vice President Sales & Marketing of Republic Tobacco, L.P but fails to provide a detailed description of the services performed and the inclusive dates of such services. Please provide this information in Petitioner's supplemental response to Interrogatory No. 19.

Interrogatory No. 24

This Interrogatory requests Petitioner identify all agreements to which it is or has been a party that refer or relate to any ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds. Contrary to Petitioner's objection, information responsive to this request is pertinent to Respondent's available claims and defenses and Petitioner's standing to petition

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for cancellation of Respondent's Marks, including Petitioner's pending trademark application, Serial No. 77/393,701, filed under Section 1(b) relying on Petitioner's bona fide intention to use the mark in commerce. Accordingly, please supplement your response to this Interrogatory and identify any such agreements, the persons most knowledgeable thereof, and all documents relating thereto.

Interrogatory No. 25

This Interrogatory requests information regarding any rights granted to Petitioner in connection with the ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds and as duplicative of Interrogatories Nos. 17 and 24. To this end, and in light of the preceding paragraph regarding the relevancy of Interrogatory No. 24, please confirm there are no "licensing agreements, authorizations, or any other rights granted to Petition in connection with the ROUTE 66 designation."

Interrogatory No. 26

This Interrogatory requests information related to the wholesale and retail prices at which all products bearing any ROUTE 66 designation are sold or expected to be sold. Petitioner objects on relevancy grounds, though this information relates to Petitioner's intent. Although Petitioner states its distributor will determine the prices, Petitioner provides no other information regarding the process by which the price is to be determined and the persons who participate in these decisions. Please provide this information in Petitioner's supplemental response to Interrogatory No. 26.

Petitioner's Responses to Document Production Requests

Document Production Req. No. 8

This request seeks: "Any and all documents regarding any action taken by Petitioner in response to its awareness of Respondent's Marks." This request is clear and direct and follows logically from Document Request No. 1 regarding the date and circumstances under which Petitioner became aware of the use or application for registration of Respondent's Marks. Accordingly, please provide a response to this request.

Document Request No. 10

This request seeks documents comprising or related to any studies, surveys, or market research tests concerning products advertised, promoted, distributed, and sold in commerce in connection with Respondent's Marks, including, but not limited to, those relating to the

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consumer perception of Respondent's Marks. This request is clear and direct. Accordingly, Respondent requests Petitioner supplement its response and provide such documents.

Document Request No. 13

This request seeks documents which disclose, describe, or otherwise relate to when Petitioner was first licensed to do business, the places it is licensed or qualified to do business, and the corporations or other entities in which Petitioner has a controlling interest. Petitioner states it will produce non-privileged documents regarding where it has sought authorization to sell ROUTE 66 branded products. In Petitioner's supplemental response to this request, please confirm Petitioner will produce non-privileged documents disclosing, describing, or otherwise relating to (i) when Petitioner was first licensed to do business in connection with the products offered or planned to be offered by Petitioner under any ROUTE 66 designation and/or (ii) the corporations or other entities in which Petitioner has a controlling interest that plan to use any ROUTE 66 designation or has at any time used any ROUTE 66 designation.

Document Request Nos. 19-21

These requests seek documents in connection with the date(s) Petitioner first marketed or sold or intends to first market or sell products under any ROUTE 66 designation, and the persons most knowledgeable regarding Petitioner's first use or intended first use of same. Petitioner's responses appear to ignore the requests to the extent they seek documents related to the date when Petitioner intends to first market or sell products, stating only that Petitioner has not yet used the mark in commerce. In Petitioner's supplemental response, please advise whether there are any responsive documents to the extent the requests involve the date Petitioner intends to first market or sell products under the ROUTE 66 designation or the person(s) most knowledgeable concerning the date when Petitioner expects to first use any ROUTE 66 designation in intrastate, interstate commerce, and/or foreign commerce.

Document Request No. 27

This Interrogatory requests Petitioner produce all documents that disclose, describe, or otherwise relate to the characteristics or profiles of the type of person or entity expected to purchase or otherwise receive the type of products planned to be sold or provided by Petitioner under any ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds. Contrary to Petitioner's objection, information responsive to this request is pertinent to Respondent's intent to use the ROUTE 66 designation, including Petitioner's pending trademark application, Serial No. 77/393,701, filed under Section 1(b) relying on Petitioner's bona fide intention to use the mark in commerce. Accordingly, please supplement your response to this request.

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Document Request No. 28

This request seeks documents related to whether Petitioner conducted or caused to be conducted a search, investigation or other inquiry concerning whether other parties had applied for, received registrations for, were using or used any ROUTE 66 designation(s). Petitioner objects on relevancy grounds, however, this information is also relevant to Petitioner's intent. Accordingly, please supplement your response to this request.

Document Request No. 31

This request seeks documents related to any license or assignment agreements to which Petitioner is a party concerning any ROUTE 66 designation. Petitioner again objects on relevancy grounds, however, this information is also relevant to Petitioner's intent and standing in this proceeding. Accordingly, please supplement your response to this request.

Document Request No. 34

This request seeks "documents that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States." Petitioner's objection that it perceives this request to be duplicative of other document requests is insufficient to avoid Petitioner's obligation to respond. This general request is discernibly different from Respondent's other requests. Accordingly, Respondent asks that Petitioner supplement its response to this request

Document Request No. 35


This request seeks, among other things, documents sufficient to identify all entities that will sell Petitioner's product(s) bearing any ROUTE 66 designation in the United States. Petitioner appears to limit its response to entities that currently sell such products, stating only that Petitioner has not yet used the ROUTE 66 mark in commerce and therefore has no such documents. In Petitioner's supplemental response, please advise that Petitioner will produce documents sufficient to identify the entities that will sell product(s) bearing any ROUTE 66 designation.

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Please advise at your earliest convenience.

Sincerely,

STITES & HARBISON, PLLC

  
Brewster Taylor

BT:CR

69985:1:ALEXANDRIA

November 3, 2008

Lara V. Klapper, Esq.  
Neal Gerber Eisenberg  
Two North LaSalle Street, Ste. 2200  
Chicago, Illinois 60602

Amy S. Cahill  
(502) 681-0597  
(502) 779-9805 FAX  
acahill@stites.com

RE: Top Tobacco, L.P. v. Van Nelle Tabak Nederland BV;  
Cancellation No. 92048989

Dear Ms. Klapper:

We have not received your response to correspondence from Brewster Taylor dated September 16, 2008 outlining the continued deficiencies in Petitioner's discovery responses. Most notably, your client has not identified or produced a single document in response to requests for production of documents or things served on June 26, 2008.

For your convenience, I summarize Petitioner's remaining deficient responses below. This correspondence serves as a final good faith effort to resolve these outstanding issues before seeking Board intervention pursuant to TBMP § 523.02.

Finally, enclosed herewith please find Respondent's responsive documents labeled VN0001 – VN0195. We ask that in addition to supplementing the discovery responses outlined in our previous correspondence and highlighted below, that your client extend the reciprocal courtesy of producing copies of responsive documents at our Alexandria, Virginia offices.

### **Petitioner's Deficient Responses**

The primary unresolved discovery issues are those surrounding Petitioner's intended use of the ROUTE 66 mark. In its Petition for Cancellation, Petitioner states:

Top Tobacco has applied for federal registration of the trademark ROUTE 66 . . . in connection with [various goods in International Classes 7 and 34].

...

Respondent's continued registration of the ROUTE 66 . . . [marks] would likely result in damage and injury to Top Tobacco in that it is likely to cause confusion, or to cause mistake, or to deceive with respect to Top Tobacco's ROUTE 66 mark.

308LT:20399:72684:1:ALEXANDRIA



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(Petition for Cancellation, Pars. 2, 11). As such, Petitioner relies on both its bona fide intent to use ROUTE 66 and on an asserted likelihood of consumer confusion between its proposed ROUTE 66 mark and Respondent's registered ROUTE 66 mark as grounds for its Petition.

Parties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party. Relevant information includes any discovery reasonably calculated to lead to the discovery of admissible evidence. Fed. R. Civ. P. 26(b)(1). Accordingly, discovery relating to Petitioner's planned use of ROUTE 66 including the goods to which the mark will be applied and the conditions surrounding sale that are relevant to likely confusion are also relevant to and discoverable in this proceeding.

**Requests for Admission 6-16 and Interrogatory Nos. 5, 6 and 9**

You have refused to admit or deny that Petitioner has, or does not have, evidence that supports its claims that Respondent abandoned the ROUTE 66 mark, and have refused to produce any documents to support such a showing. Without a proper objection or response to these requests, we will ask the Board to deem the requests admitted pursuant to TBMP § 524.01, Fed. R. Civ. P. 36(a).

Your client has now received all responsive non-privileged documents in Respondent's possession, custody or control requested in discovery. Therefore, Petitioner's previous objection that the disputed requests involve documents in Respondent's possession lacks grounds.

Please supplement the responses to requests for admissions 6-16 and interrogatories 5, 6 and 9.

**Interrogatory No. 11**

Your client has not responded to Interrogatory No. 11, and instead has relied on the attorney-client privilege. This reliance is improper. The identification of discovery documents (as opposed to their substance) is not privileged or confidential. TBMP § 414(1); *see Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975). Petitioner may state whether it received any opinions concerning Respondents' marks, without revealing the substance of those communications.

**Interrogatory No. 12**

We await production of the investigation Petitioner performed in connection with Respondent's proposed use of its ROUTE 66 mark in the United States referred to in Petitioner's previous responses.

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**Interrogatory No. 14**

Petitioner concedes the relevance of this interrogatory directed to its plans to use the ROUTE 66 mark in the U.S. by admitting that it "intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the Route 66 mark in commerce" in the United States. However, the interrogatory seeks more than the existence of Petitioner's "intent." Please provide information about any steps Petitioner has taken towards its intended use of ROUTE 66 and any documents relating thereto.

**Interrogatory No. 19**

We continue to await a complete answer to this interrogatory, which seeks a description of the services performed and the dates of those services performed for Petitioner in connection with Petitioner's products to be sold in connection with any ROUTE 66 designation. Please provide this information in supplemental form.

**Interrogatory Nos. 24 and 25 and Request No. 31**

Agreements relating to the mark in question, including license agreements or other arrangements between the owner and third-parties are discoverable. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988). Please identify all agreements requested in these discovery requests, and those individuals with information relating thereto.

**Interrogatory No. 26**

Petitioner states that its distributors will set prices for the products bearing its intended ROUTE 66 mark. Please provide a manufacturer's "suggested retail price," or price range(s) at which the goods will be offered for sale to consumers.

**Request No. 8**

We continue to await documents regarding any action take by Petitioner in response to its awareness of Respondent's Marks. Petitioner's response states: (1) that it does not understand the request and (2) that the request is overbroad and unduly burdensome. Petitioner chose to file a petition for cancellation after becoming aware of Respondent's marks. Any documents relating to the decision on, and subsequent action related to, filing the petition are among the documents that are sought by this request.

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**Request No. 10**

Studies, surveys, or market research, or documents concerning consumer perceptions relating thereto concerning Respondent's products intended to be sold under the proposed ROUTE 66 mark are relevant to the grounds Petitioner asserts in its petition for cancellation. Please supplement Petitioner's responses to include this information.

**Request No. 13**

You have agreed to produce responsive documents relating to when Petitioner was first licensed to do business, the places it is licensed or qualified to do business, and the corporations or other entities in which petitioner has a controlling interest. Please produce these documents at your earliest convenience.

**Request Nos. 19-21**

Petitioner asserts an intent to begin using ROUTE 66 as a mark in the United States in connection with specified goods. These requests nos. 19- 21 seek additional documents surrounding this intended use, including documents that show the dates on which Petitioner intends to first market or sell products under the ROUTE 66 mark, and the persons most knowledgeable of these activities. The requests are directed to intrastate, interstate and foreign commerce.

Although in some cases a party's foreign use is irrelevant in Board proceedings, there are exceptions, for example, where "there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purposes of forestalling a foreign user's expansion into the United States." TBMP § 414(13); *see Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991)(in view of Applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market).

**Request No. 27**

Respondent's request for production of documents relating to the types of persons expected to purchase Petitioner's planned ROUTE 66 products is relevant. The classes of customers for a party's involved goods or services are discoverable in Board proceedings. TBMP § 414(3). Please produce any documents responsive to this request.

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**Request No. 28**

Documents relating to the search of a mark at issue, including search reports, are discoverable in Board proceedings. TBMP § 414(6). Please produce any searches conducted by or on behalf of Petitioner for the proposed ROUTE 66 mark and related documents encompassed by this request.

**Request No. 34**

To the extent that Petitioner has not responded sufficiently to the requests and interrogatories outlined in this letter, Request No. 34 seeking documents relating to Petitioner's bona fide intent to use the ROUTE 66 mark cannot be duplicative. Petitioner cannot complain about answering a question the second time, when it did not answer the request the first time around.


In the interest of clarity, we rephrase the request to seek "documents not otherwise produced, that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States."

**Request No. 35**

This request is similarly directed to Petitioner's intent to sell products in the United States under the ROUTE 66 mark. Obviously, the entities and sales channels through which Petitioner will sell products is relevant to the grounds Petitioner asserts for its petition, namely a likelihood of consumer confusion, and are generally discoverable in Board proceedings.

As the close of discovery is quickly approaching, we ask that you make the necessary supplementation and produce all responsive documents on or before **November 15, 2008**.

Very truly yours,

  
Amy S. Cahill

ASC:lms

cc: Brewster Taylor

November 21, 2008

**VIA EMAIL & U.S. MAIL**

Amy S. Cahill  
Stites & Harbison PLLC  
400 West Market Street, Suite 1800  
Louisville, KY 40202-3352

Re: *Top Tobacco L.P. v. Van Nelle Tobacco Netherland B.V.*  
Cancellation No. 92048989

Dear Ms. Cahill:

This letter is in response to your letter dated November 3, 2008, and Brewster Taylor's letter dated September 16, 2008.

**Van Nelle's Responses to Top Tobacco's Discovery Requests**

***Top Tobacco's Definition of the term "ROUTE 66 Mark"***

The inclusion by Top Tobacco, L.P. of expired U.S. Registration No. 1,686,628 ('628 Registration) in its definition of "ROUTE 66 mark", is entirely proper and does not render any of Top Tobacco's discovery requests overly-broad or unduly burdensome. While the '628 Registration is no longer a subject of the present cancellation proceedings, the mark depicted in the '628 Registration shares common characteristics with both Registration Nos. 2,950,896 (the '896 Registration) and 3,328,623 (the '623 Registration), including the shield design and word elements.

Contrary to the position taken in Mr. Taylor's September 16, 2008 letter, use by Van Nelle of any "ROUTE 66" mark in any format is relevant to the present cancellation proceedings. The caselaw cited by Mr. Taylor is inapposite. Initially, all three cited cases were decided on summary judgment, and thus, dealt only with a presumption of abandonment —not whether the prior use or registration of marks related to a mark registered under Section 44(e) are relevant for discovery purposes. This is an important distinction. For example, in *Hawaiian Hosts, Inc. v. Roundtree MacKintosh PLC*, 225 U.S.P.Q. 628, 630 (TTAB 1985), the plaintiff was opposing the applicant's pending application under Section 44(e), not cancelling an existing registration. In that context, the Board held that there was no requirement that an *applicant* under Section 44(e) use the mark prior to registration, and hence, evidence of past non-use or abandonment was not relevant to registration of the pending application. However, in the present case, Top Tobacco is seeking to *cancel an existing registration*, not oppose a pending application. The present proceedings were instituted four months after issuance of the '623 Registration and nearly three years after the issuance of the '896 Registration. As provided

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under *Imperial Tobacco Ltd. v. Phillip Morris, Inc.*, 14 U.S.P.Q.2d 1390, 1392 (Fed. Cir. 1990): “A Section 44(e) registrant is entitled only to the same national treatment as any other registrant.” As is the case with the alleged abandonment of any registered mark, Top Tobacco is entitled to receive discovery to show that Van Nelle had not used the mark and that it ceased its use of the mark with an intent not to resume such use. Accordingly, Van Nelle’s past use of marks related to any “ROUTE 66” mark — including but not limited to the mark registered in the ‘628 Registration — is relevant to this proceeding.

Additionally, a proper timeframe for discovery related to Van Nelle’s use and non-use of any “ROUTE 66” marks extends to any timeframe, even if it pre-dates the registration of the ‘896 and ‘623 marks. *Consolidated Cigar Corp. v. Rodriguez*, 65 U.S.P.Q.2d 1153, 1155 (TTAB 2002), was decided on summary judgment based on the petitioner’s reliance on a *presumption* of abandonment for three years of non-use, but the decision did not involve a showing that the applicant intended not to resume use of the mark, as pled in the present proceeding. Accordingly, the scope of Top Tobacco’s definition of the “ROUTE 66 Mark”, and the timeframe sought under the discovery requests are all relevant and reasonably calculated to lead to the discovery of admissible evidence.

***Interrogatory No. 1***

As discussed above, the time periods prior to registration of the ‘896 and ‘623 Registrations are relevant to the issue of Van Nelle’s intent not to resume use of its marks. If, however, it is Van Nelle’s position that use outside of the United States is not relevant to showing that Van Nelle had no intention to resume use of its marks in the United States, then we will accept your objection on the basis of such foreign use.

***Interrogatory No. 2***

In Mr. Taylor’s September 16, 2008 letter, he states that Van Nelle will obtain identification of relevant principals of Commonwealth Brands, Inc. and it will also obtain confirmation and identification of relevant principals of J.D. Getty Enterprises, Inc. This information was not included with your November 3, 2008 letter, and accordingly, we ask that you furnish this to us.

***Interrogatory No. 13***

As explained above, Van Nelle’s abandonment of its ‘628 Registration, as well as its discontinuance of use of any “ROUTE 66” marks are relevant to Van Nelle’s intent not to resume use of its ‘896 and ‘523 Registrations, and are, therefore, relevant and reasonably calculated to lead to the discovery of admissible evidence in this proceeding. Accordingly, please respond to Interrogatory Number 13.

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***Document Request No. 16-17***

Referring to its discussion above, documents relating to Van Nelle's decision to abandon its "ROUTE 66" marks, including its '628 Registration, are directly relevant to and reasonably calculated to lead to the discovery of admissible evidence related to Van Nelle's intent not to resume use of its marks under the '896 and '623 Registrations.

***Document Request No. 32***

In Mr. Taylor's September 6, 2008 letter, he stated that he would inquire whether there are any documents that specifically relate to Van Nelle's document retention policy; accordingly, please advise us whether such document(s) exists.

**Top Tobacco's Responses to Van Nelle's Discovery Requests**

***Top Tobacco's Intended Use of the ROUTE 66 Mark***

With regard to Top Tobacco's intent to use its ROUTE 66 mark, we have collected documents to be produced early next week. Beyond the threshold of showing bona fide intent, in your November 3, 2008 letter, Van Nelle takes the general position that discovery related to Top Tobacco's planned use of ROUTE 66 is discoverable. Without reference to any specific request, Top Tobacco responds that its pending application identifies the goods to which the mark will be applied, namely, tobacco, cigarette papers, cigarette filters, cigarette tubes, cigarette rolling papers, cigarette injecting machines and kits for making cigarettes. Given that the marks in question are substantially identical and goods in question are nearly identical to the goods registered under the subject registrations, it is disingenuous to argue that there would be a lack of a likelihood of confusion between the parties' marks. Rather, beyond the threshold issue of Top Tobacco's bona fide intent to file its application for purposes of standing, the basis of the proceeding is the abandonment of the registered marks, not a likelihood of confusion. Accordingly, discovery into all the potential factors for likelihood of confusion is irrelevant and overly broad and unduly burdensome.

***Requests For Admission 6-16 and Interrogatories 5, 6, and 9***

Contrary to the characterization in your November 3, 2008 letter, Top Tobacco has, in fact, responded to these Requests, stating that it "denies" each of these Requests to Admit. To the extent that these denials are subject to objections, Top Tobacco's objections are appropriate. For example, the Requests are directed to documentary or other evidence that show "that Respondent discontinued use in the United States of the Mark of ROUTE 66" — the *discontinuance* of use of a mark would not reasonably appear in any documentation, with the possible exception of documents held by Van Nelle. That said, the documents now produced by Van Nelle, as well as the statements made in Mr. Taylor's September 16, 2008 letter, support Top Tobacco's contention that Respondent discontinued its use in the United States of the mark

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ROUTE 66 in any and all forms in connection with Applicant's goods. Accordingly, Top Tobacco's responses to the Requests for Admission 6-16 are properly denied, and are consistent with Top Tobacco's responses to Interrogatory Nos. 5, 6, and 9.

***Interrogatory No. 11***

Initially, Top Tobacco responded to Interrogatory No. 11 by objecting under both attorney-client privilege and work product doctrine. For Interrogatory No. 11, Top Tobacco asserts the work product doctrine regarding whether Petitioner received any opinions concerning the non-use, abandonment, or intent not to resume use of Respondent's marks. As such, the legal authority relied upon in the November 3, 2008 letter is inapposite. Whether any such opinion was received (or not) reflects counsel's mental impressions, theories and the development of its case in preparing for the present litigation. As a result, whether or not such opinions were sought or received is protected by the work product doctrine. If Van Nelle is aware of additional authority that holds such information as not protected by the work product doctrine, please let us know.

***Interrogatory No. 12***

It is unclear why Van Nelle requests production of a document under the heading of an interrogatory. Top Tobacco's statement that it performed an investigation regarding any possible use of the "ROUTE 66" Marks fully responds to the interrogatory. In addition, Top Tobacco's response to Interrogatory No. 12 states that an investigation was conducted, but does not identify whether any documents were created and it is unclear what is requested in your letter by awaiting the "production of the investigation" — it is unclear how an investigation can be produced. Finally, to the extent that there is any documentation relating to the investigation, and such documentation falls within one of Van Nelle's document requests, such documents are protected work product (see response to Interrogatory No. 11 above), and therefore we believe not discoverable.

***Interrogatory No. 14***

Top Tobacco's answer to Interrogatory No. 14 is proper and complete. The Interrogatory asks to "identify all plans Petitioner has to advertise, offer and sell products using 'ROUTE 66' and identify all documents relating thereto, and the person most knowledgeable thereof." Top Tobacco identified its plans for how it intends to use the mark and identified the individual most knowledgeable of these plans. Top Tobacco will be producing next week documents that relate to its plans to use the mark.

***Interrogatory No. 19***

Pursuant to Rule 33(d), Fed. R. Civ. P., Top Tobacco will produce business records identifying the services performed by DRL Enterprises, Inc.



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***Interrogatory Nos. 24 and 25 and Request No. 31***

Both Mr. Taylor's September 16 and your November 3, 2008 letters fail to identify how either of these Interrogatories or Document Request is relevant to or reasonably calculated to lead to the discovery of admissible evidence in this case. Rather than explain how it might be relevant, Van Nelle simply asserts that the "agreements relating to the work in question, including license agreements...are discoverable" and cites to *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 U.S.P.Q. 2d 171 (TTAB 1988), taking the case completely out of context. In *Johnston Pump*, the opposer's license agreement was relevant to the use and strength of the opposer's mark, which bore directly on the likelihood of confusion asserted by the opposer in the opposition. In contrast, the present cancellation proceeding centers around Van Nelle's abandonment of its registered marks and has no bearing on the strength of Top Tobacco's marks or the likelihood of confusion. Accordingly, neither of these Interrogatories or Document Request is relevant, and Top Tobacco stands on its objections.

***Interrogatory No. 26***

Top Tobacco has fully answered this Interrogatory. Its answer states that Top Tobacco has not sold any products bearing the ROUTE 66 Mark and that its distributor, Republic Tobacco, LP, "will determine the prices for petitioner's products to be sold under its ROUTE 66 Mark." No further information is called for or required at this time.

***Document Request No. 8***

Van Nelle requested "any and all documents regarding any action taken by petitioner in response to its awareness of Respondent's Marks." Top Tobacco responded that it did not understand what documents Van Nelle sought by its request regarding "any action taken by petitioner in response to its awareness." In your November 3, 2008, you have revised this Request to seek "any documents relating to the decision on, and subsequent action relating to, filing the petition." Responding to this new, revised Request, Top Tobacco states that Van Nelle is already in possession of any documents filed by Top Tobacco in this proceeding, and any other documents relating to Top Tobacco's decision to file a petition for cancellation and subsequent action relating to the Petition to Cancel are objected to as being the subject of attorney-client privilege or protected by the work product doctrine.

***Document Request No. 10***

As Document Request No. 10 has been revised in your November 3, 2008 letter, Top Tobacco states that it objects to the Request because it seeks documents that are not relevant and not reasonably calculated to lead to the discovery of admissible evidence. As stated above, the determinative issue in this case relates to the abandonment of *Van Nelle's* registered marks, not consumer surveys or consumer perceptions relating to *Top Tobacco's* mark.

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***Document Request No. 13***

Top Tobacco agreed to “produce at a mutually convenient time and place non-privileged documents regarding where it has sought authorization to sell ROUTE 66 branded products.” Accordingly, Top Tobacco will produce such responsive documents early next week. Beyond that, however, though Mr. Taylor’s September 13, 2008 letter requested the following expanded list of documents, including “when petitioner was first licensed to do business, the places it is licensed or qualified to do business, and the corporations or entities in which petitioner has a controlling interest,” at no time has Top Tobacco agreed to produce such documents. To the contrary, Top Tobacco objected to the request on the grounds that it seeks documents that are neither relevant to the issues raised in Top Tobacco’s petition for cancellation nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Your mischaracterization in your November 3, 2008 letter stating that Top Tobacco had agreed to produce such documents is completely improper, and Top Tobacco maintains its objections to such Request.

***Document Request Nos. 19-21***

In Mr. Taylor’s September 16, 2008 letter, he requests that Top Tobacco advise whether there are any responsive documents “to the extent the Request involves the date petitioner intends to first market or sell products on ROUTE 66 designation, or the person(s) most knowledgeable concerning the date when petitioner expects to first use any ROUTE 66 designation in intrastate, interstate, and/or foreign commerce.” First, Top Tobacco’s responses to these Document Requests state that Top Tobacco “has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.” This includes any documents related to Top Tobacco’s intent to first market or sell products under the ROUTE 66 designation. Second, Mr. Taylor’s letter goes on to request the identification of persons — which is not an appropriate request under a document request — and regardless, the request would be duplicative of Van Nelle’s Interrogatory No. 14, which has been already answered. Finally, as you acknowledge in your November 3, 2008 letter, a party’s foreign use is irrelevant in Board proceedings, subject only to narrow exception. *Double J of Broward, Inc. v. Skolony Sportswear DMBH*, 21 U.S.P.Q. 2d 1609, 1612 (TTAB 1991) (“Information concerning applicant’s foreign activities, including foreign trademark applications and/or registrations, is not relevant to the issues in an opposition proceeding.”). Indeed, the exception to this rule did not apply in *Double J of Broward* to which you cite in your letter, and does not apply here.

***Document Request No. 27***

This Document Request relates to “the characteristics or profiles of the person or entity that purchases or receives or is expected to purchase or otherwise receive, the types of products that are sold or provided, or are planned to be sold and/or provided by petitioner under any rule, “ROUTE 66 designation.” This subject matter is not relevant to the issues in this Cancellation — namely, Van Nelle’s abandonment of its registered marks. Your letter simply asserts a

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general rule and cites to TMBP Section 414(3). The basis for this general rule derives from *Johnston Pump/General Valve, Inc. v. Chromally American Corp.*, 10 U.S.P.Q. 2d 1671 (TTAB 1988), in which the contested issue was whether there was a likelihood of confusion between the opposer's and the applicant's marks. In the present case, Top Tobacco's application is for a nearly identical mark and for nearly identical goods as those in Van Nelle's registrations, and thus, any factors contributing to the likelihood of confusion are not at issue. Accordingly, Top Tobacco maintains its objections.

***Document Request No. 28***

Van Nelle again blindly cites a general rule, TBMP § 414(6), claiming that "search reports are discoverable in Board proceedings," but this rule is non-responsive to Top Tobacco's objection. Section 414(6) of the TBMP addresses the issue of whether search reports are protected by the attorney-client privilege, but that is not the only basis upon which Top Tobacco has objected to this Document Request. Mr. Taylor claims, without any support, that the Document Request is relevant to Top Tobacco's intent (presumably Top Tobacco's intent to use the mark in its pending application), but does not explain how it is relevant. Moreover, to the extent that the purpose of this request is simply to identify documents related to Top Tobacco's intent to use the mark, is duplicative of other document requests. In addition, to the extent counsel conducted any searches called for under the Request, such decisions are protected by work product doctrine, which is not addressed under TBMP, Section 414(6) or the cases cited therein. Accordingly, unless Van Nelle can provide authority to the contrary, Top Tobacco maintains its objections.

***Document Request No. 34***

Based on the clarification in your November 3, 2008 letter, Top Tobacco states that it is not presently aware of any documents, not otherwise produced or the subject of the attorney-client privilege or protected by the work product doctrine, that disclose, describe, or otherwise relate to petitioner's bona fide intent to use the ROUTE 66 designation in the United States.

***Document Request No. 35***

Top Tobacco has fully responded to this Document Request.

**Meet and Confer**

Based on the exchange of letters, it appears that both parties believe that the opposing party has an obligation to supplement its discovery responses. Accordingly, we propose scheduling a telephone conference after you receive Top Tobacco's documents next week, during which we can resolve or narrow meet and confer to see whether we can resolve or narrow talk through resolution of any of these issues prior to either party filing a motion to compel. In

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addition, we would like to discuss potential dates for depositions. Please let us know your availability for such a conference call.

Very truly yours,



Michael G. Kelber

MGK:adw

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